

TTAB

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 19, 2006

Opposition No 91168695

Serial No. 76619826

DAVID SHYMATTA
425 N. COLUMBIA CENTER BLVD. N201
KENNEWICK, WA 99336

BellSouth Intellectual Property
Corporation

v.

Shymatta, David

Stephen M. Schaetzel
Kilpatrick Stockton LLP
1100 Peachtree Street Suite 2800
Atlanta, GA 30309-4530

Eric McWilliams, Paralegal Specialist:

A notice of opposition to the registration sought in the above-identified application has been filed. The notice of opposition can be viewed and printed at <http://ttabvue.uspto.gov/>

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.



02-02-2006

U.S. Patent & TMO/c/TM Mail Rpt Dt. #30

Discovery and testimony periods are set as follows:

Discovery period to open: February 08, 2006

Discovery period to close: August 07, 2006

30-day testimony period for party
in position of plaintiff to close: November 05, 2006

30-day testimony period for party
in position of defendant to close: January 04, 2007

15-day rebuttal testimony period
for plaintiff to close: February 18, 2007

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BELLSOUTH INTELLECTUAL
PROPERTY CORPORATION,

Opposer,

v.

DAVID SHYMATTA

Applicant.

)
)
)
) In the matter of Application
) Serial No. 76/619,826
) Mark: CELL BELLS
)
)

) Opposition No. _____
)
)

NOTICE OF OPPOSITION

Opposer, BellSouth Intellectual Property Corporation ("BIPCO"), a Delaware corporation located at 824 Market Street, Suite 901, Wilmington, Delaware 19801, believes that it will be damaged by the registration of Applicant's CELL BELLS mark (Serial No. 76/619,826) and opposes the same pursuant to 15 U.S.C. §1063, and 37 C.F.R. §§2.101 and

2.104(a). The grounds for opposition are as follows:

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1.

BIPCO is a wholly-owned subsidiary of BellSouth Corporation. BellSouth Corporation and its affiliates offer and provide a variety of telecommunications goods and services. BIPCO owns a family of Bell Marks, including the famous marks BELL, the BELL Symbol, and BELLSOUTH. BIPCO licenses these marks to BellSouth Corporation



and its affiliates, which in turn offer and provide a variety of telecommunications goods and services under the famous trademarks.

2.

BIPCO's Bell Marks, including the famous marks BELL and the BELL Symbol, have been used by BIPCO's licensees and their predecessors for more than 100 years in association with a wide variety of telecommunications goods and services.

3.

Prior to the divestiture of the American Telephone & Telegraph Company ("AT&T"), the "Bell System" included twenty-two (22) "Bell" operating telephone companies that provided telecommunications goods and services. Each "Bell" operating company was owned by AT&T and each had the right to use the "Bell" name and marks, including the word mark BELL. United States v. Western Electric Co., Inc., 569 F. Supp. 1057, 1062, n. 5, 1074, 1077-81 (D.D.C. 1983).

4.

Each "Bell" operating company shared in the "Bell System" heritage, and the related goodwill, as represented by the "Bell" name and marks, including the marks BELL and the BELL Symbol. As a result of their exclusive and extensive use by the "Bell" operating companies, the "Bell" name and marks acquired significant goodwill and became famous trademarks.

5.

Pursuant to the orders of the United States District Court for the District of Columbia (the "D.C. Court") in Civil Action No. 82-0192, the Bell operating companies were divested from AT&T, United States v. American Tel. and Tel. Co., 552 F. Supp. 131 (D.D.C. 1982), and seven regional companies were established as holding companies for these former "Bell" system telephone companies, United States v. Western Elec. Co., 569 F. Supp. 1057, 1062, n. 5 (D.D.C. 1983). BellSouth Corporation is one of these original seven holding companies.

6.

Pursuant to the orders of the D.C. Court, AT&T assigned all of its right, title and interest in the "Bell" name and marks to the regional holding companies so that they could use the "Bell" name and marks in their "existing relationship to telephone subscribers." United States v. Western Elec. Co., 569 F. Supp. at 1077-81.

7.


The D.C. Court ordered the issuance of concurrent federal registrations to the regional companies, including BellSouth Corporation. The Patent and Trademark Office subsequently issued concurrent use registrations to the regional companies, including BellSouth Corporation. The D.C. Court oversaw and approved the assignment, and the issuance of concurrent use registrations for the "Bell" name and marks assigned by AT&T to the regional companies, including BellSouth Corporation. United States v. Western Electric, Inc., et al., C.A. No. 82-0192 (D.D.C. February 6, 1984).


8.

Upon divestiture, BellSouth Corporation and/or its affiliates adopted, used and/or continued use of the "Bell" name and marks in accordance with the orders and opinions of the D.C. Court so as to maintain a family of Bell marks (the "Bell Marks"), including the word mark BELL, the BELL Symbol, and the word mark BELLSouth. Since divestiture, BellSouth Corporation and its affiliates have continued to use the Bell Marks in accordance with the opinions and orders of the D.C. Court.

9.

On September 1, 1998, BellSouth Corporation assigned all of its rights, title and interests in the Bell Marks to BIPCO. Accordingly, BIPCO is a successor-in-interest to BellSouth Corporation. BIPCO currently owns the following registrations and licenses the use of the following marks to BellSouth Corporation and its affiliates:

Mark	Goods & Services	Date of Registration	Remarks
BELL Symbol Reg. No. 1,327,695 	"Telecommunications services" in International Class 38.	October 5, 1971	<ul style="list-style-type: none"> • Incontestable • Famous
BELL Reg. No. 1,565,562	"[T]elecommunications networks...; telephones and telephone accessories; modems;...facsimile machines...; telephone answering machines; voice mail systems...and controls for delivering and receiving	November 14, 1989	<ul style="list-style-type: none"> • Incontestable • Famous

Mark	Goods & Services	Date of Registration	Remarks
	<p>messages over telephone lines..." in International Class 9;</p> <p>"Telephone, classified and business directories..." in International Class 16;</p> <p>"Installing and maintaining telecommunications systems and equipment for others" in International Class 37;</p> <p>"Designing and engineering telecommunications systems..." in International Class 42;</p> <p>"[M]anaging telecommunications systems and equipment for others" in International Class 35;</p> <p>"Providing telecommunications services to others" in International Class 38.</p>		
<p>BELL Symbol Reg. No. 1,569,327</p> 	<p>"Customer premises telecommunications networks and parts therefor; telephones and telephone accessories..." in International Class 9;</p> <p>"Telephone, classified and business directories..." in International Class 16;</p> <p>"Promoting the goods and services of others through consulting on directory advertising programs, designing directory advertisements and listings and placing such advertisements and listings in directories..." in International Class 35;</p>	<p>December 5, 1989</p>	<ul style="list-style-type: none"> • Incontestable • Famous

Mark	Goods & Services	Date of Registration	Remarks
	<p>"Installing and maintaining telecommunications systems and equipment for others" in International Class 37;</p> <p>"Providing educational services, seminars and workshops in telecommunications skills and the use of telecommunications equipment and services" in International Class 41;</p> <p>"Designing and engineering telecommunications systems and equipment for others and related consulting services" in International Class 42;</p>		
BELL Reg. No. 2,718,321	<p>"Computer software to enable electronic commerce..." in International Class 9;</p> <p>"Telecommunications services..." in International Class 38,</p> <p>"Entertainment and educational services..." in International Class 41;</p> <p>"Hosting of web sites of others..." in International Class 42.</p>	May 27, 2003	<ul style="list-style-type: none"> Famous
BELLSOUTH Reg. No. 1,459,196	<p>"Telephone and business directories..." in International Class 16;</p> <p>"Promoting the goods and services of others through consulting on directory advertising programs; designing directory advertisements and</p>	September 29, 1987	<ul style="list-style-type: none"> Incontestable Famous

Mark	Goods & Services	Date of Registration	Remarks
	<p>listings and placing such advertisements and listings in directories; managing telecommunications systems and equipment for others" in International Class 35;</p> <p>"Installing and maintaining telecommunications systems and equipment for others" in International Class 37;</p> <p>"Providing telecommunications services to others" in International Class 38;</p> <p>"Providing educational services, seminars and workshops in telecommunications skills and the use of telecommunications equipment and services" in International Class 41;</p> <p>"Designing and engineering telecommunications systems and equipment for others and related consulting services" in International Class 42.</p>		
<p>BELLSOUTH Reg. No. 1,565,559</p>	<p>"Customer premises telecommunications networks and parts therefore; telephones and telephone accessories; modems; computers; printers; facsimile machines; multiplexors; computer terminals; telephone answering machines; voice mail systems comprising telephone and computer interface, computer programs, and controls for delivering and receiving messages</p>	<p>August 15, 1989</p>	<ul style="list-style-type: none"> • Incontestable • Famous

Mark	Goods & Services	Date of Registration	Remarks
	over telephone lines; and computer programs dealing with telecommunications and business management." in International Class 9.		
BELLSOUTH Reg. No. 2,244,189	<p>"Computer software which facilitates searching for and transferring information across global computer communications networks, and for the execution of business transactions using global computer communications networks..." in International Class 9;</p> <p>"Telecommunications services, namely, electronic transmission of data, sound, text, image messages, video and documents via computer network terminals...; telecommunications gateway services..." in International Class 38;</p> <p>"Providing multiple-user access to a multi-media telecommunications network for the transfer and dissemination of a wide range of information..." in International Class 42.</p>	May 11, 1999	<ul style="list-style-type: none"> • Famous • Incontestable

See, respectively, Exhibits 1-7 hereto. All use of these marks inures to the benefit of BIPCO.

10.

Judicial authorities have recognized the marks BELL, the BELL Symbol, and BELLSOUTH as famous trademarks. For example, in deciding a motion for summary

judgment in Opposition No. 87,654, styled BellSouth Corporation v. B.E.L.-Tronics Ltd., the Trademark Trial and Appeal Board stated: “[BIPCO] has a well-known group of marks based on the famous “BELL” mark. Members of this group of marks incorporate various other terms and designs in conjunction with the word “BELL.” See Exhibit 8 hereto. Furthermore, in BellSouth Corp. v. B.E.L.-Tronics Ltd., United States District Court for the Northern District of Georgia, Civil Action No. 1-93-CV-1714-CC, the court stated: “The mark [BELL] has been and continues to be a famous trademark.” The court further stated: “BellSouth established ownership of a family of Bell Marks by using and promoting the BELL Mark together in such a manner as to create among purchasers an association of common ownership with the historical BELL system and is entitled to broader protection.” See Exhibit 9, pp. 22, 24 hereto.

11.

By virtue of continuous and extensive sales and advertising in connection with telecommunications-related goods and services, the marks BELL, the BELL Symbol, and BELLSOUTH continue to be famous, and widely and favorably known to the public throughout the United States. Moreover, the marks BELL, the BELL Symbol, and BELLSOUTH became famous before any act complained of herein, and these marks continue to be famous and entitled to a broad scope of protection.

12.

BIPCO owns and BellSouth Corporation and its affiliates continue to use a group of well-known marks based on the famous BELL mark for a wide variety of telecommunications-related goods and services.

13.

BellSouth Telecommunications, Inc. ("BST"), a wholly-owned subsidiary of BellSouth Corporation, uses the famous mark BELLSOUTH in connection with the offering of Cingular Wireless service through BST. More specifically, as shown by the advertisement provided at <<http://www.bellsouth.com/consumer/wireless/index.html>>, a BellSouth customer may obtain retail wireless services and telephones through BST. See Exhibit 10 hereto.

14.

On or about November 4, 2004, Applicant David Shymatta ("Shymatta") filed a use-based application to register the CELL BELLS mark on the Principal Register. This application was assigned Serial No. 76/619,826.

15.

On or about August 24, 2005, Shymatta's application Serial No. 76/619,826 was published for opposition. As published, Shymatta's application identified the relevant goods and/or services as providing, "retail store services featuring cell phone accessories" in International Class 35.

16

After the CELL BELLS mark was published in the Official Gazette, BIPCO timely requested extensions of time in which to file a Notice of Opposition, which continue through and including January 11, 2006.

17.

On information and belief, Shymatta is using the CELL BELLS mark in connection with telecommunications-related goods and services.

18.

BIPCO will be damaged by registration of Applicant's CELL BELLS mark because the CELL BELLS mark so closely resembles BIPCO's famous BELL and BELLSOUTH Marks, both of which were used in connection with telecommunications-related goods and services, and registered in the United States in connection with telecommunications-related goods and services, long before the date of Applicant's first use of the CELL BELLS mark that consumer confusion, mistake and deception are likely to result.

19.

The relevant public is likely to be confused into believing that Applicant's telecommunications-related services as offered under the CELL BELLS mark and which are similar to the telecommunications-related goods and services offered by BIPCO under the licensed Bell Marks, are offered by a BellSouth affiliate, or authorized, licensed, endorsed or sponsored by BIPCO or one of its licensees. Registration of Applicant's mark on the

Principal Register would thus be inconsistent with BIPCO's exclusive rights in the Bell Marks and BIPCO's family of Bell Marks.

20.

BIPCO will be damaged by registration of Applicant's CELL BELLS mark because the subject mark so resembles BIPCO's previously used, federally registered, and famous Bell Marks as to be likely, when used on or in connection with the telecommunications-related goods and services identified in Applicant's application Serial No. 76/619,826 to cause confusion, or to cause mistake, or to deceive in violation of Section 2 of the Lanham Act, 15 U.S.C. § 1052.

21.

BIPCO will be damaged by registration of Applicant's CELL BELLS mark because the subject mark dilutes and is likely to dilute the distinctiveness of BIPCO's famous Bell Marks by eroding consumers' exclusive identification of these famous marks with BIPCO and its licensees, and/or by tarnishing and degrading the positive associations and prestigious connotations of the famous Bell Marks, and/or by otherwise lessening the capacity of the Bell Marks to identify and distinguish the goods and services of BIPCO and its licensees.

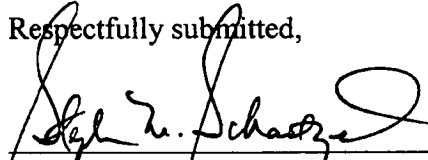
22.

One original and two duplicate copies of this Notice of Opposition are enclosed. A check in the amount of \$300.00 to cover the filing fee is enclosed with the Notice of Opposition. The Commissioner is authorized to debit the deposit account of Kilpatrick Stockton LLP (deposit account no. 11-0860) for any deficiency in the required fee.

WHEREFORE, BIPCO requests that Application Serial No. 76/619,826 be refused and this Notice of Opposition be sustained in favor of BIPCO.

This 11th day of January, 2006.

Respectfully submitted,



Stephen M. Schaetzel
KILPATRICK STOCKTON LLP
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Suite 2800
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(404) 815-6500 (telephone)
(404) 815-6555 (facsimile)
sschaetzel@kilpatrickstockton.com
Attorney for Opposer

CERTIFICATE OF MAILING

I hereby certify that the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service as Express Mail No. EV607733925US in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

This the 11th day of January, 2006.


Lauren T. Estrin

EXHIBIT 1

Int. Cl.: 38

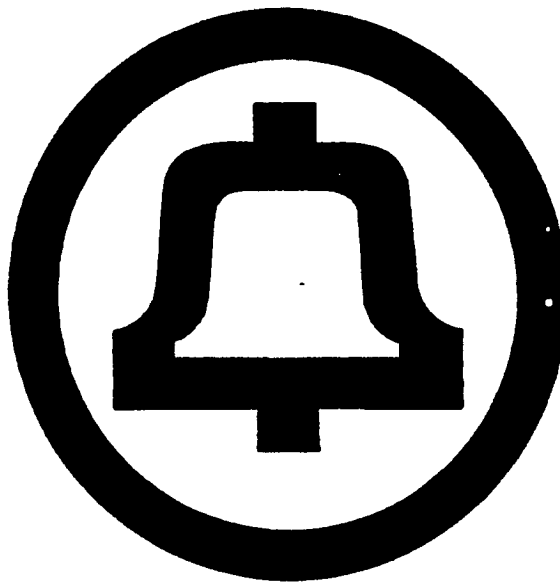
Prior U.S. Cl.: 104

Reg. No. 1,327,695

United States Patent and Trademark Office

Registered Oct. 5, 1971

**SERVICE MARK
PRINCIPAL REGISTER
CONCURRENT USE**



**BELLSOUTH CORPORATION (GEORGIA CORPORATION)
675 WEST PEACHTREE STREET, N.E.
ATLANTA, GA 30375, ASSIGNEE OF AMERICAN TELEPHONE AND TELEGRAPH COMPANY (NEW YORK CORPORATION) NEW YORK, NY 10007**

**FOR: TELECOMMUNICATION SERVICES,
IN CLASS 38 (U.S. CL. 104).**

FIRST USE 8-18-1969, FIRST USED IN A DIFFERENT FORM IN 1889; IN COMMERCE 8-18-1969, FIRST USED IN A DIFFERENT FORM IN 1889.

**ORIGINALLY REGISTERED ON OCT. 5, 1971
AS REG. NO. 921,734 AND SER. NO. 381,697.**

THIS IS A CONCURRENT REGISTRATION ISSUED PURSUANT TO THE OPINIONS AND ORDERS OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA IN UNITED STATES V. WESTERN ELECTRIC CO., INC., CIVIL ACTION NO. 82-0192, DATED JULY 8, 1983 AND FEBRUARY 6, 1984, AND SECTIONS 2(D) AND 37 OF THE LANHAM ACT, 15 U.S.C. SECTIONS 1052(D) AND 1119. REGISTRATION IS NATIONWIDE, BUT IS SUBJECT TO THE CONDITION THAT

REGISTRANT SHALL USE THE MARK ONLY IN CONJUNCTION WITH ONE OR MORE OF THE FOLLOWING MODIFIERS: "BELLSOUTH," "SOUTH CENTRAL BELL," "SOUTHERN BELL." USE OF A MODIFIER SHALL BE CONSIDERED TO BE IN CONJUNCTION WITH THE MARK IF IT IS USED IN SUFFICIENT PROXIMITY TO THE MARK SUCH THAT A REASONABLE OBSERVER WOULD NORMALLY VIEW THE MARK AND THE MODIFIER IN A SINGLE VISUAL IMPRESSION AND WOULD RECOGNIZE THAT BOTH THE MARK AND THE MODIFIER ARE BEING USED BY REGISTRANT.

REGISTRANT'S RIGHT TO EXCLUSIVE USE OF THE MARK IS SUBJECT TO THE RIGHTS OF THE FOLLOWING COMPANIES, TO WHICH CONCURRENT REGISTRATIONS IN THE MARK HAVE ALSO BEEN ISSUED, TO USE THE MARK IN CONJUNCTION WITH ONE OR MORE OF THE MODIFIERS SPECIFIED IN THOSE REGISTRATIONS:

AMERICAN INFORMATION
TECHNOLOGIES CORPORATION
225 WEST RANDOLPH STREET
CHICAGO, IL 60606

BELL ATLANTIC CORPORATION
1310 NORTH COURT HOUSE ROAD
ARLINGTON, VA 22216

CINCINNATI BELL INC.
201 EAST FOURTH STREET
CINCINNATI, OH 45202

NYNEX CORPORATION
335 MADISON AVENUE
NEW YORK, NY 10017

PACIFIC TELESIS GROUP
140 NEW MONTGOMERY STREET
SAN FRANCISCO, CA 94105

THE SOUTHERN NEW ENGLAND
TELEPHONE COMPANY
227 CHURCH STREET
NEW HAVEN, CT 06506

SOUTHWESTERN BELL CORPORATION
1010 PINE STREET
ST. LOUIS, MO 63101

U S WEST, INC.
7800 EAST ORCHARD ROAD
ENGLEWOOD, CO 80111

OWNER OF U.S. REG. NO. 649,454.

SER. NO. 81/327,695 , FILED 1-22-1971.

KIMBERLY KREHELY, EXAMINING ATTOR-
NEY

EXHIBIT 2

Int. Cls.: 9, 16, 35, 37, 38, 41 and 42

Prior U.S. Cls.: 21, 26, 38, 100, 101, 103, 104 and 107

United States Patent and Trademark Office

Reg. No. 1,565,562

Registered Nov. 14, 1989

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

BELL

BELLSOUTH CORPORATION (GEORGIA CORPORATION)
SUITE 1800
1155 PEACHTREE STREET, N.E.
ATLANTA, GA 303676000

FOR: CUSTOMER PREMISES TELECOMMUNICATIONS NETWORKS AND PARTS THEREFOR; TELEPHONES AND TELEPHONE ACCESSORIES; MODEMS; COMPUTERS; PRINTERS; FACSIMILE MACHINES; MULTIPLEXORS; COMPUTER TERMINALS; TELEPHONE ANSWERING MACHINES; VOICE MAIL SYSTEMS COMPRISING TELEPHONE AND COMPUTER INTERFACE, COMPUTER PROGRAMS, AND CONTROLS FOR DELIVERING AND RECEIVING MESSAGES OVER TELEPHONE LINES; AND COMPUTER PROGRAMS DEALING WITH TELECOMMUNICATIONS AND BUSINESS MANAGEMENT, IN CLASS 9 (U.S. CLS. 21, 26 AND 38).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: TELEPHONE, CLASSIFIED AND BUSINESS DIRECTORIES; AND EDUCATIONAL PRINTED PUBLICATIONS IN TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 16 (U.S. CL. 38).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: PROMOTING THE GOODS AND SERVICES OF OTHERS THROUGH CONSULTING ON DIRECTORY ADVERTISING PROGRAMS, DESIGNING DIRECTORY ADVERTISEMENTS

AND LISTINGS AND PLACING SUCH ADVERTISEMENTS AND LISTINGS IN DIRECTORIES; AND MANAGING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 35 (U.S. CLS. 101 AND 104).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: INSTALLING AND MAINTAINING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 37 (U.S. CL. 103).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: PROVIDING TELECOMMUNICATIONS SERVICES TO OTHERS, IN CLASS 38 (U.S. CL. 104).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: PROVIDING EDUCATIONAL SERVICES, SEMINARS AND WORKSHOPS IN TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 1-0-1968; IN COMMERCE 1-0-1968.

FOR: DESIGNING AND ENGINEERING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS AND RELATED CONSULTING SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 104).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

THIS IS A CONCURRENT REGISTRATION ISSUED PURSUANT TO THE OPINIONS OF

THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA IN UNITED STATES V. WESTERN ELECTRIC CO., INC., CIVIL ACTION NO. 82-0192, DATED JULY 8, 1983, AND FEBRUARY 6, 1984, AND SECTIONS 2(D) AND 37 OF THE LANHAM ACT, 15 U.S.C. SECTIONS 1052(D) AND 1119. REGISTRATION IS NATIONWIDE, BUT IS SUBJECT TO THE CONDITION THAT REGISTRANT SHALL USE THE MARK ONLY IN CONJUNCTION WITH ONE OR MORE OF THE FOLLOWING MODIFIERS; "SOUTHERN BELL", "SOUTH CENTRAL BELL", "BELLSOUTH". USE OF A MODIFIER SHALL BE CONSIDERED TO BE IN CONJUNCTION WITH THE MARK IF IT IS USED IN SUFFICIENT PROXIMITY TO THE MARK SUCH THAT A REASONABLE OBSERVER WOULD NORMALLY VIEW THE MARK AND THE MODIFIER IS A SINGLE VISUAL IMPRESSION AND WOULD RECOGNIZE THAT BOTH THE MARK AND THE MODIFIER ARE USED BY REGISTRANT. REGISTRANT'S RIGHT TO EXCLUSIVE USE OF THE MARK IS SUBJECT TO THE RIGHTS OF THE FOLLOWING COMPANIES, TO WHICH CONCURRENT REGISTRATIONS IN

THE MARK HAVE ALSO BEEN ISSUED, TO USE THE MARK IN CONJUNCTION WITH ONE OR MORE OF THE MODIFIERS SPECIFIED IN THOSE REGISTRATIONS; AMERICAN INFORMATION TECHNOLOGIES CORPORATION, 30 SOUTH WACKER DRIVE, CHICAGO, IL 60606; BELL ATLANTIC CORPORATION, 1600 MARKET STREET, PHILADELPHIA, PA 19103; CINCINNATI BELL INC., 201 EAST FOURTH STREET, CINCINNATI, OH 45202; NYNEX CORPORATION, 400 WEST-CHESTER AVENUE, WHITE PLAINS, NY 10604; PACIFIC TELESIS GROUP, 130 KEARNY STREET, SAN FRANCISCO, CA 94108; THE SOUTHERN NEW ENGLAND TELEPHONE COMPANY, 227 CHURCH STREET, NEW HAVEN, CT 06506; SOUTHWESTERN BELL CORPORATION, ONE BELL CENTER, ST. LOUIS, MO 63101; AND U S WEST, INC., 7800 EAST ORCHARD ROAD, ENGLEWOOD, CO 80111.

OWNER OF U.S. REG. NOS. 1,327,668, 1,459,998 AND OTHERS.

SER. NO. 727,722, FILED 5-11-1988.

SHARON R. MARSH, EXAMINING ATTORNEY

EXHIBIT 3

Int. Cls.: 9, 16, 35, 37, 41 and 42

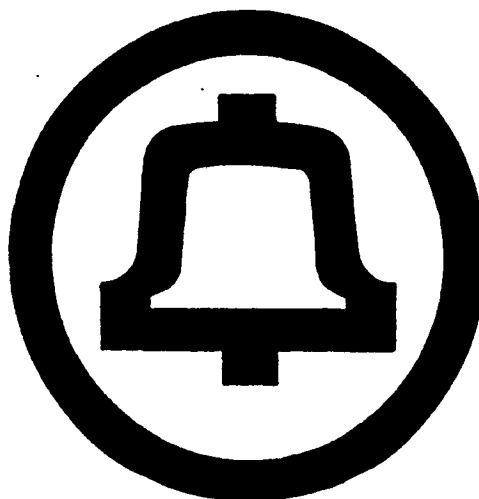
Prior U.S. Cls.: 21, 26, 38, 100, 101, 103, 104 and 107

United States Patent and Trademark Office

Reg. No. 1,569,327

Registered Dec. 5, 1989

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



**BELLSOUTH CORPORATION (GEORGIA CORPORATION)
SUITE 1800
1155 PEACHTREE STREET, N.E.
ATLANTA, GA 303676000**

FOR: CUSTOMER PREMISES TELECOMMUNICATIONS NETWORKS AND PARTS THEREFOR; TELEPHONES AND TELEPHONE ACCESSORIES; MODEMS; COMPUTERS; PRINTERS; FACSIMILE MACHINES; MULTIPLEXORS; COMPUTER TERMINALS; TELEPHONE ANSWERING MACHINES; VOICE MAIL SYSTEMS COMPRISING TELEPHONE AND COMPUTER INTERFACE, COMPUTER PROGRAMS, AND CONTROLS FOR DELIVERING AND RECEIVING MESSAGES OVER TELEPHONE LINES; AND COMPUTER PRO-

GRAMS DEALING WITH TELECOMMUNICATIONS AND BUSINESS MANAGEMENT, IN CLASS 9 (U.S. CLS. 21, 26 AND 38).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: TELEPHONE, CLASSIFIED AND BUSINESS DIRECTORIES; AND EDUCATIONAL PRINTED PUBLICATIONS IN TELEPHONE TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 16 (U.S. CL. 38).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: PROMOTING THE GOODS AND SERVICES OF OTHERS THROUGH CONSULTING ON DIRECTORY ADVERTISING PROGRAMS, DESIGNING DIRECTORY ADVERTISEMENTS

AND LISTINGS AND PLACING SUCH ADVERTISEMENTS AND LISTINGS IN DIRECTORIES, AND MANAGING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 35 (U.S. CLS. 101 AND 104).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: INSTALLING AND MAINTAINING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 37 (U.S. CL. 103).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

FOR: PROVIDING EDUCATIONAL SERVICES, SEMINARS AND WORKSHOPS IN TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 1-0-1968; IN COMMERCE 1-0-1968.

FOR: DESIGNING AND ENGINEERING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS AND RELATED CONSULTING SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 104).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1900.

THIS IS A CONCURRENT REGISTRATION ISSUED PURSUANT TO THE OPINIONS OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA IN UNITED STATES V. WESTERN ELECTRIC CO., INC., CIVIL ACTION NO. 82-0192, DATED JULY 8, 1983, AND FEBRUARY 6, 1984, AND SECTIONS 2(D) AND 37 OF THE LANHAM ACT, 15 U.S.C. SECTIONS 1052(D) AND 1119. REGISTRATION IS NATIONWIDE, BUT IS SUBJECT TO THE CONDITION THAT REGISTRANT SHALL USE THE MARK ONLY IN CONJUNCTION WITH ONE OR MORE OF THE FOLLOWING MODIFIERS: "SOUTHERN BELL", "SOUTH CEN-

TRAL BELL", "BELLSOUTH". USE OF A MODIFIER SHALL BE CONSIDERED TO BE IN CONJUNCTION WITH THE MARK IF IT IS USED IN SUFFICIENT PROXIMITY TO THE MARK SUCH THAT A REASONABLE OBSERVER WOULD NORMALLY VIEW THE MARK AND THE MODIFIER IN A SINGLE VISUAL IMPRESSION AND WOULD RECOGNIZE THAT BOTH THE MARK AND THE MODIFIER ARE USED BY REGISTRANT. REGISTRANT'S RIGHT TO EXCLUSIVE USE OF THE MARK IS SUBJECT TO THE RIGHTS OF THE FOLLOWING COMPANIES, TO WHICH CONCURRENT REGISTRATIONS IN THE MARK HAVE ALSO BEEN ISSUED, TO USE THE MARK IN CONJUNCTION WITH ONE OR MORE OF THE MODIFIERS SPECIFIED IN THOSE REGISTRATIONS: THE SOUTHERN NEW ENGLAND TELEPHONE COMPANY, 277 CHURCH STREET, NEW HAVEN, CT 06506; SOUTHWESTERN BELL CORPORATION, ONE BELL CENTER, ST. LOUIS, MO 63101; U S WEST, INC., 7800 EAST ORCHARD ROAD, ENGLEWOOD, CO 80111; AMERICAN INFORMATION TECHNOLOGIES CORPORATION, 30 SOUTH WACKER DRIVE, CHICAGO, IL 60606; BELL ATLANTIC CORPORATION, 1600 MARKET STREET, PHILADELPHIA, PA 19103; CINCINNATI BELL INC., 201 EAST FOURTH STREET, CINCINNATI, OH 45202; NYNEX CORPORATION, 400 WEST-CHESTER AVENUE, WHITE PLAINS, NY 10604; PACIFIC TELESIS GROUP, 130 KEARNY STREET, SAN FRANCISCO, CA 94108.

OWNER OF U.S. REG. NOS. 1,327,668, 1,459,998 AND OTHERS.

SER. NO. 727,723, FILED 5-11-1988.

SHARON R. MARSH, EXAMINING ATTORNEY

EXHIBIT 4

Int. Cls.: 9, 38, 41 and 42

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101, 104 and 107

Reg. No. 2,718,321

United States Patent and Trademark Office

Registered May 27, 2003

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

BELL

**BELLSOUTH INTELLECTUAL PROPERTY COR-
PORATION (DELAWARE CORPORATION)
824 MARKET STREET
WILMINGTON, DE 19801**

FOR: COMPUTER SOFTWARE TO ENABLE ELECTRONIC COMMERCE, NAMELY, COMPUTER ELECTRONIC COMMERCE SOFTWARE TO ALLOW USERS TO PERFORM ELECTRONIC BUSINESS TRANSACTIONS VIA A GLOBAL COMPUTER NETWORK; COMPUTER SOFTWARE FOR ENABLING ACCESS TO AND NAVIGATION OF GLOBAL COMPUTER NETWORKS, INTERNAL COMPUTER NETWORKS, NETWORKS OF TELEVISIONS, ON-LINE SERVICES AND COMPUTER BULLETIN BOARDS; COMPUTER SOFTWARE FOR TRANSFERRING INFORMATION ACROSS GLOBAL COMPUTER COMMUNICATION NETWORKS; ELECTRONIC PUBLICATIONS DOWNLOADABLE TO A PERSONAL COMPUTER OR TELEVISION VIA A GLOBAL COMPUTER NETWORK ON A VARIETY OF FIELDS; COMPUTER GAMES DOWNLOADABLE TO A PERSONAL COMPUTER OR TELEVISION VIA A GLOBAL COMPUTER NETWORK, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 8-16-1996; IN COMMERCE 8-16-1996.

FOR: TELECOMMUNICATIONS SERVICES; NAMELY, ELECTRONIC TRANSMISSION OF MESSAGES, DATA, IMAGES, VIDEO AND INFORMATION VIA A GLOBAL COMPUTER COMMUNICATIONS NETWORK; PROVIDING TELECOMMUNICATIONS CONNECTIONS TO A GLOBAL COMPUTER NETWORK, ON-LINE SERVICES AND BULLETIN BOARDS; PROVIDING MULTIPLE USER ACCESS TO A GLOBAL COMPUTER NETWORK WHICH ALLOWS USERS TO ACCESS THE ONLINE COMPUTER SERVICES AND ONLINE COMPUTER BULLETIN BOARDS OF OTHERS; PROVIDING ACCESS TO A GLOBAL COMPUTER INFORMATION NETWORK THAT

ENABLES USERS TO INTERACT WITH ONLINE SOFTWARE APPLICATIONS PROGRAMS AND RECEIVE INFORMATION; ELECTRONIC MAIL SERVICES; PROVIDING FILE SERVER HOSTING SERVICES; PROVIDING MULTIPLE USER ACCESS TO A GLOBAL COMPUTER NETWORK FOR THE TRANSFER AND DISSEMINATION OF A WIDE RANGE OF INFORMATION; PROVIDING TELECOMMUNICATIONS CONNECTIONS TO BACKBONE COMPUTER NETWORK TO ENABLE OTHERS TO TRANSMIT CONTENT OVER A GLOBAL COMPUTER INFORMATION NETWORK, PROVIDING ACCESS TO AN ELECTRONIC INTERACTIVE NETWORK WHICH ENABLES USERS TO ACCESS APPLICATIONS AND INFORMATION, FACILITATES THE EXCHANGE OF INFORMATION AMONG USERS, AND ALLOWS USERS TO PURCHASE PRODUCTS ON-LINE, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 8-16-1996; IN COMMERCE 8-16-1996.

FOR: ENTERTAINMENT AND EDUCATIONAL SERVICES, NAMELY CONDUCTING CLASSES, SEMINARS AND WORKSHOPS OVER A GLOBAL COMPUTER NETWORK IN THE FIELD OF TELECOMMUNICATIONS AND COMPUTER SOFTWARE TRAINING, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 8-16-1996; IN COMMERCE 8-16-1996.

FOR: HOSTING OF WEB SITES OF OTHERS ON COMPUTER SERVER HARDWARE ACCESSIBLE FROM A GLOBAL COMPUTER NETWORK; DEVELOPMENT AND MAINTENANCE OF WEB SERVERS SOFTWARE FOR OTHERS; AND COMPUTER CONSULTATION FOR OTHERS; PROVIDING COMMUNITY INFORMATION OVER A GLOBAL COMPUTER INFORMATION NETWORK, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 8-16-1996; IN COMMERCE 8-16-1996.

REGISTRATION PURSUANT TO THE OPINIONS OF THE UNITED STATES DISTRICT COURT AS CITED ABOVE- AMERICAN INFORMATION TECHNOLOGIES CORPORATION, 30 SOUTH WACKER DRIVE, CHICAGO, IL 60606; BELL ATLANTIC CORPORATION, 1310 NORTH COURTHOUSE ROAD, ARLINGTON, VA 22201; CINCINNATI BELL, INC., 201 EAST FOURTH STREET, CINCINNATI, OH 45202; NYNEX CORPORATION, 1113 WESTCHESTER AVENUE, WHITE PLAINS, NY 10604; PACIFIC TELESIS GROUP, 130 KEARNY STREET, SAN FRANCISCO, CA 94108; THE SOUTHERN NEW ENGLAND TELEPHONE COMPANY, 227

CHURCH STREET, NEW HAVEN, CT 06506; SOUTHWESTERN BELL CORPORATION, ONE BELL CENTER, ST. LOUIS, MO 63101; AND U S WEST, INC., 6200 SOUTH QUEBEC ROAD, ENGLEWOOD, CO. 80111. CONCURRENT USE APPLICATION SERIAL NO. 75/681755

OWNER OF U.S. REG. NOS. 1,327,677, 1,565,562 AND OTHERS.

SER. NO. 75-681,755, FILED 4-13-1999.

IRENE D. WILLIAMS, EXAMINING ATTORNEY

EXHIBIT 5

Int. Cls.: 16, 35, 37, 38, 41 and 42

Prior U.S. Cls.: 38, 100, 101, 103, 104 and 107

United States Patent and Trademark Office

Reg. No. 1,459,196

Registered Sep. 29, 1987

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

BELLSOUTH

BELLSOUTH CORPORATION (GEORGIA CORPORATION)
675 W. PEACHTREE ST., N.E.
ATLANTA, GA 30375

FOR: TELEPHONE AND BUSINESS DIRECTORIES AND EDUCATIONAL BOOKS AND PAMPHLETS IN TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 16 (U.S. CL. 38).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

FOR: PROMOTING THE GOODS AND SERVICES OF OTHERS THROUGH CONSULTING ON DIRECTORY ADVERTISING PROGRAMS; DESIGNING DIRECTORY ADVERTISEMENTS AND LISTINGS AND PLACING SUCH ADVERTISEMENTS AND LISTINGS IN DIRECTORIES; MANAGING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 35 (U.S. CL. 101).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

FOR: INSTALLING AND MAINTAINING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS, IN CLASS 37 (U.S. CL. 103).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

FOR: PROVIDING TELECOMMUNICATIONS SERVICES TO OTHERS, IN CLASS 38 (U.S. CL. 104).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

FOR: PROVIDING EDUCATIONAL SERVICES, SEMINARS AND WORKSHOPS IN TELECOMMUNICATIONS SKILLS AND THE USE OF TELECOMMUNICATIONS EQUIPMENT AND SERVICES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

FOR: DESIGNING AND ENGINEERING TELECOMMUNICATIONS SYSTEMS AND EQUIPMENT FOR OTHERS AND RELATED CONSULTING SERVICES, IN CLASS 42 (U.S. CL. 100).

FIRST USE 1-3-1984; IN COMMERCE 1-3-1984.

OWNER OF U.S. REG. NOS. 1,327,668, 1,327,758 AND OTHERS.

SER. NO. 622,503, FILED 9-29-1986.

DAVID SOROKA, EXAMINING ATTORNEY

EXHIBIT 6

Int. Cl.: 9

Prior U.S. Cls.: 21, 26 and 38

Reg. No. 1,565,559

United States Patent and Trademark Office Registered Nov. 14, 1989

**TRADEMARK
PRINCIPAL REGISTER**

BELLSOUTH

BELLSOUTH CORPORATION (GEORGIA CORPORATION)
SUITE 1800
1155 PEACHTREE STREET, N.E.
ATLANTA, GA 303676000

FOR: CUSTOMER PREMISES TELECOMMUNICATIONS NETWORKS AND PARTS THEREFOR; TELEPHONES AND TELEPHONE ACCESSORIES; MODEMS; COMPUTERS; PRINTERS; FACSIMILE MACHINES; MULTIPLEXORS; COMPUTER TERMINALS; TELEPHONE ANSWERING MACHINES; VOICE MAIL SYSTEMS COMPRISING TELEPHONE AND COMPUTER INTERFACE, COMPUTER PROGRAMS, AND CONTROLS FOR DELIVERING AND RECEIVING MESSAGES OVER TELEPHONE LINES; AND COMPUTER PROGRAMS DEALING WITH TELECOMMUNICATIONS AND BUSINESS MANAGEMENT, IN CLASS 9 (U.S. CLS. 21, 26 AND 38).

FIRST USE 6-1-1984; IN COMMERCE 6-1-1984.

THIS IS A REGISTRATION ISSUED PURSUANT TO THE OPINIONS OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA IN UNITED STATES V. WESTERN ELECTRIC CO., INC., CIVIL ACTION NO. 82-0192, DATED JULY 8, 1983, AND FEBRUARY 6, 1984, AND SECTION 2(D) OF THE LANHAM ACT, 15 U.S.C. SECTION 1052(D). BECAUSE REGISTRANT SHARES THE COMMON HERITAGE OF RIGHTS AND RELATED GOODWILL IN THE "BELL" ELEMENT OF THE COMPOSITE MARK WITH

OTHER FORMER MEMBERS OF THE BELL SYSTEM, REGISTRANT'S RIGHT TO EXCLUSIVE USE OF THE "BELL" ELEMENT OF THE COMPOSITE MARK IS SUBJECT TO THE CONCURRENT RIGHTS WHICH THE FOLLOWING COMPANIES HAVE IN THE "BELL" MARK AS SPECIFIED IN THE OPINIONS OF THE UNITED STATES DISTRICT COURT AS CITED ABOVE; AMERICAN INFORMATION TECHNOLOGIES CORPORATION, 30 SOUTH WACKER DRIVE, CHICAGO, IL 60606; BELL ATLANTIC CORPORATION, 1310 NORTH COURT HOUSE ROAD, ARLINGTON, VA 22216; BELLSOUTH CORPORATION, 675 WEST PEACHTREE STREET, N.E., ATLANTA, GA 30375; CINCINNATI BELL INC., 201 EAST FOURTH STREET, CINCINNATI, OH 45202; NYNEX CORPORATION, 335 MADISON AVENUE, NEW YORK, NY 10017; PACIFIC TELESIS GROUP, 140 NEW MONTGOMERY STREET, SAN FRANCISCO, CA 94105; THE SOUTHERN NEW ENGLAND TELEPHONE COMPANY, 227 CHURCH STREET, NEW HAVEN, CT 06506; SOUTHWESTERN BELL CORPORATION, ONE BELL CENTER, ST. LOUIS, MO 63101; AND U S WEST, INC., 7800 EAST ORCHARD ROAD, ENGLEWOOD, CO 80111.

OWNER OF U.S. REG. NOS. 1,317,695, 1,459,998 AND OTHERS.

SER. NO. 719,542, FILED 3-29-1988.

SHARON R. MARSH, EXAMINING ATTORNEY

EXHIBIT 7

Int. Cls.: 9, 38 and 42

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 104

Reg. No. 2,244,189

United States Patent and Trademark Office

Registered May 11, 1999

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

BELLSOUTH

**BELLSOUTH CORPORATION (GEORGIA CORPORATION)
1155 PEACHTREE STREET, N.E.
ATLANTA, GA 303093610**

FOR: COMPUTER SOFTWARE WHICH FACILITATES SEARCHING FOR AND TRANSFERRING INFORMATION ACROSS GLOBAL COMPUTER COMMUNICATIONS NETWORKS, AND FOR THE EXECUTION OF BUSINESS TRANSACTIONS USING GLOBAL COMPUTER COMMUNICATIONS NETWORKS; REMOTE CONTROL UNITS FOR TELEVISION, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 8-16-1996; IN COMMERCE 8-27-1996.

FOR: TELECOMMUNICATIONS SERVICES, NAMELY, ELECTRONIC TRANSMISSION OF DATA, SOUND, TEXT, IMAGE MESSAGES, VIDEO AND DOCUMENTS VIA COMPUTER NETWORK TERMINALS, SET-TOP BOXES AND TELEVISION RECEIVERS; TELECOMMUNICATIONS GATEWAY SERVICES; PROVIDING TELECOMMUNICATIONS CONNECTIONS TO A GLOBAL COMPUTER NETWORK; ELECTRONIC MAIL SERVICES; ELECTRONIC STORE-AND-FORWARD MESSAGING SERVICES, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 8-16-1996; IN COMMERCE 8-27-1996.

FOR: PROVIDING MULTIPLE-USER ACCESS TO A MULTI-MEDIA TELECOMMUNICATIONS NETWORK FOR THE TRANSFER AND DISSEMINATION OF A WIDE RANGE OF INFORMATION, NAMELY, MOVIES, MUSIC, LOCAL, NATIONAL, CABLE AND SATELITE TELEVISION PROGRAMMING, EDUCATIONAL PROGRAMMING, NEWS, SPORTS, WEATHER AND INFORMATION OF INTEREST TO THE GENERAL PUBLIC ON A RANGE OF TOPICS; PROVIDING ACCESS TO A GLOBAL COMPUTER INFORMATION NETWORK FOR THE TRANSFER AND DISSEMINATION OF A WIDE RANGE OF INFORMATION, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 8-16-1996; IN COMMERCE 8-27-1996.

OWNER OF U.S. REG. NOS. 1,459,196, 2,020,258 AND OTHERS.

SER. NO. 75-273,982, FILED 4-14-1997.

WILLIAM P. SHANAHAN, EXAMINING ATTORNEY

EXHIBIT 8

Goodwin/decisions



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED

JUN 22 1994

PAT.&T.M. OFFICE

Opposition-No. 86,941

Ameritech Corporation

v.

B.E.L-Tronics Limited

Before Sams, Rice and Cissel Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 11, 1991 B.E.L-Tronics Limited, a Canadian corporation, applied to register the mark shown below



BEL-TRONICS

on the Principal Register for "cordless telephones." The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce on these products.

On February 10, 1992 a timely Notice of Opposition was filed by Ameritech Corporation, a Delaware corporation. Opposer asserted ownership and registration of a number of marks incorporating the word "BELL." These marks are: "BELL Logo," for telephone, audio program, telegraph, television, telephotograph,

telemetering, signaling and remote control services; radio paging services; (1) "BELLBOY" for radio paging services; (2) "BELL Design" for telecommunication services; (3) and "OHIO BELL;" (4) "WISCONSIN BELL;" (5) "ILLINOIS BELL;" (6) "INDIANA BELL;" (7) "MICHIGAN BELL;" (8) "BELL;" (9) and "BELL Design;" (10) all for a variety of goods and services in the telecommunications field. Opposer pleaded that as a result of continuous and extensive use and promotion of the "BELL" family of marks by opposer and its predecessor, these "BELL" marks are valuable assets of opposer, and that applicant's mark, as applied to the goods set forth in the application, so resembles opposer's marks that confusion is likely.

Applicant's answer denied the essential allegations of opposer and "counterclaimed" to have the Board "strike" opposer's complaint and declare its filing to have been fraudulent.

- (1) Registration No. 1,327,675, issued July 30, 1957; renewed.
- (2) Registration No. 1,327,684, issued July 5, 1960; renewed.
- (3) Registration No. 1,327,693, issued October 5, 1971; renewed.
- (4) Registration No. 1,459,190, issued September 29, 1987; partial Section 8 affidavit accepted.
- (5) Registration No. 1,459,192, issued September 29, 1987; partial Section 8 affidavit accepted.
- (6) Registration No. 1,459,193, issued September 29, 1987; partial Section 8 affidavit accepted.
- (7) Registration No. 1,459,199, issued September 29, 1987; partial Section 8 affidavit accepted.
- (8) Registration No. 1,459,196, issued October 6, 1987; partial Section 8 affidavit accepted.
- (9) Registration No. 1,545,197, issued June 27, 1989.

Opposition No. 86,941

Applicant also asked the Board to declare opposer's counsel to have violated the Rules of Practice. Opposer denied these allegations.

On July 23, 1992 applicant moved to consolidate Opposition Nos. 86,941; 87,459; 87,460; 87,654; and 88,259. The other oppositions were brought by NYNEX Corporation, U.S. West, Inc., BellSouth Corporation, and Southwestern Bell, each of which had filed a separate notice of opposition. On October 22, 1992 the motion to consolidate was denied, and applicant's "counterclaim" was stricken.

On November 9, 1992 applicant filed an amended answer which asserts as an "affirmative defense" that opposer has unclean hands because its use of the marks which it asserts against applicant has been unlawful, i.e., in violation of orders of the United States District Court for the District of Columbia.

This case now comes up on opposer's January 1, 1993 motion for summary judgment. Submitted in support of the motion were three volumes of materials, including fifty-seven different exhibits, and a fourth volume containing four additional exhibits of a confidential nature which are subject to a protective order. Opposer also filed a brief in support of its motion for summary judgment, and applicant submitted a brief responsive to the motion, along with sixteen exhibits.

(10) Registration No. 1,545,198, issued June 27, 1989.

Opposer's subsequent motion to file a reply brief is hereby granted, although applicant opposed it. To grant such a motion is within the Board's discretion. -In the case at hand we choose to exercise our discretion and consider opposer's reply brief in an effort to understand more clearly the factual and legal arguments made by the parties.

As has often been stated, the purpose of the summary judgment motion procedure is judicial economy, namely, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the motion for summary judgment could not be reasonably expected to change the result. See, e.g., *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984) and *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 941 (Fed. Cir. 1984). The burden in a motion for summary judgment is on the moving party to establish prima facie that there is no genuine issue of material fact and that it is entitled to a judgment as a matter of law. Fed. R. Civ. P. 56(c).

Moreover, on a motion for summary judgment, the function of the Board is not to try issues of fact, but rather to determine if there are any genuine issues of material fact to be tried. In this regard, all doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party and, similarly, all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. See *Flatley v. Trump*, 11 USPQ2d 1284, 1287 (TTAB 1989) and cases cited therein.

If, by virtue of the pleadings, depositions, answers to interrogatories, admissions, or affidavits, it is clear that there is no genuine issue as to any material fact, and that the party moving for summary judgment is entitled to judgment in its favor as a matter of law, such a judgment shall be rendered. Fed. R. Civ. P. 56(c). The party adverse to a properly supported motion for summary judgment cannot rest on its pleading, but rather must set forth, by affidavits or as otherwise provided by Rule 56, specific facts showing that there is a genuine issue for trial. Rule 56(e).

Careful consideration of the materials submitted by the parties in this case reveals that there are not any genuine issues of material fact which would require a trial. Opposer has established a factual basis for the Board to conclude that confusion is likely. Applicant has not met its burden under paragraph (e) of Rule 56 of setting forth facts which show that disputes exist as to facts material to the pleaded issues, nor has applicant shown that based on the undisputed facts, opposer is not entitled to judgment as a matter of law as to both the issue of likelihood of confusion and the issue presented by applicant's affirmative defense.

When the materials of record in connection with the motion are evaluated in light of the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), to determine whether confusion is likely, we find that the undisputed facts show that applicant's mark, if applied to cordless telephones,

Opposition No. 86,541

would so resemble opposer's famous mark "BELL" and the bell design, as well as the other related marks incorporating the word "BELL" registered for opposer's telecommunications products and services, that confusion would be likely. The primary materials from which we have reached this conclusion are the affidavit of Raymond Lewis, the person in charge of market communications and advertising for Ameritech Service, Inc., which is a wholly-owned subsidiary of a wholly-owned subsidiary of opposer; the affidavit of Nicki Hilligos, a sales manager for Ameritech Services, Inc., and the deposition testimony of Rudolf Sagl, Vice President of applicant.

The dominant portion of applicant's mark clearly is the word "BEL," which appears in large block letters inside an oval design. The word is repeated below this presentation of it, combined with the term "tronics," as "Bel-tronics." The additional term, "tronics," is plainly suggestive of "electronics," which is the field in which applicant has done business for years, selling electronic devices such as radar detectors and satellite receiving antennas.

Opposer, as noted above, has registered the mark "BELL", as well as bell designs and marks which combine the word "BELL" or the bell designs with other words or designs, all for telecommunication products and services.

The dominant, common portion of all of opposer's word marks and marks which combine "BELL" with designs is the word "BELL," which of course is derived from the name of the famous inventor of the telephone, Alexander Graham Bell. He founded the American Bell Telephone Company in 1889, and the company began using the mark "BELL" then in connection with telephones and related goods and services. That company merged with AT&T, which in turn was opposer's predecessor in interest with regard to the mark "BELL."

The marks of the parties to this proceeding are similar. The fact that in the "BELL" marks of opposer there are two "L's in "BELL," whereas the dominant term in applicant's mark, "BEL," has only one, is not a sufficient basis for concluding that consumers would believe that opposer's marks and the mark of applicant were indicative of different sources. In appearance, pronunciation and connotation the marks are similar.

That the term "Bel" also has an obscure technological meaning related to logarithms used to measure the intensity of voltage or sound does not create a material factual dispute. Applicant's slogan, "Clear as a BEL," makes it abundantly clear that the commercial impression created by "BEL" in applicant's mark is that of a bell.

If these similar marks were to be used on applicant's cordless telephones and in connection with opposer's telecommunications goods and services, including cordless telephones, confusion would unquestionably be likely. This is especially so in view of the extensive use over a great many years of the "BELL" mark and the many marks in which "BELL" and/or the bell design appear. By any imaginable standard, "BELL" is a famous mark in the telecommunications field. There is no genuine issue of fact material to this issue.

Applicant makes a number of arguments as to why summary judgment is not appropriate and why confusion is unlikely. None is quite as dubious as its first argument, that the quantity of papers submitted in support of opposer's motion alone "indicates a high probability that at least a few disputed material facts are lurking in those papers." (brief, p.6). None of the arguments of applicant, however, has merit.

Applicant's main argument against granting summary judgment to opposer centers on the way opposer uses its various marks and the rights and requirements established by an order of the United States District Court of the District of Columbia. Some background concerning what precipitated the order is necessary in order to understand it.

The materials of record in connection with the motion show that opposer is one of the seven Regional Bell Operating Companies (RBOCs) which were set up as a result of the divestiture of AT&T in 1984. At that time the trademark "BELL" and the related "BELL" trademarks which had long been used by AT&T were transferred to opposer and the other RBOCs by Court order. See: United States v. Western Electric Co., 569 F. Supp. 1057, (D.D.C.), aff'd, California v. United States, 464 U.S. 1013 (1983). Opposer and the other RBOCs have continued to use the "BELL" marks in connection with a wide variety of goods and services in the field of telecommunications. Opposer has a well-known group of marks based on the famous "BELL" mark. Members of this group of marks incorporate various other terms and designs in conjunction with the word "BELL".

As part of the divestiture of AT&T in 1984, AT&T transferred its rights in the "BELL" names and marks to opposer and the other RBOCs, and to two other former AT&T companies. Each of these entities became a concurrent user of the marks. Each owns registrations reflecting its right as a concurrent user.

To avoid confusion, a supplemental agreement was reached and was approved by the Court. Under the terms of the agreement, each concurrent user is allowed to use the marks on a nationwide basis in conjunction with specified modifiers. Opposer's specified

modifiers include "AMERITECH," "ILLINOIS BELL," "OHIO BELL," "WISCONSIN TELEPHONE," and others. Under the terms of the Court order, use of the modifier in conjunction with the mark is accomplished if the modifier is "used in sufficient proximity to the mark such that a reasonable observer would normally view the mark and the modifier in a single visual impression and would recognize that both the mark and the modifier are used by registrant." Paragraph 1(c) of the supplemental agreement (Exhibit 5) specifically states, however, that in order to be "used in conjunction with" the mark, the modifier does not have to be "used next to or in direct proximity to" the mark in question.

Applicant takes the position that "BELL" alone cannot be the basis for opposer's assertion that it has a family of marks because the various marks asserted to be in the family have never been promoted together as a family and because, under the terms of the Court's order, "BELL" cannot be used alone. Applicant argues further that in their entireties, opposer's marks do not so resemble applicant's mark that confusion is likely; that the connotations of the marks differ; that factual disputes exist as to the strength of opposer's marks; that the goods set forth in the application are not closely related to opposer's services; and that opposer should not be allowed to prevail in this proceeding because of "misuse of registrations."

Applicant's arguments against summary judgment, as noted above, are not well taken. To begin, we turn to the assertion that opposer should be denied judgment because it has "unclean hands." There is simply no basis for contending that genuine issues of fact related to this defense exist. Applicant admits, (response to Request No. 75 of opposer's second set of requests for admissions) that it has absolutely no evidence showing any such "misuse of registrations." No such evidence has been made of record in connection with the summary judgment motion. Under these circumstances applicant has clearly failed to meet its burden under Rule 56 to show, by affidavits or otherwise, that some factual dispute exists which necessitates a trial on this issue.

Instead, applicant simply argues that opposer cannot claim ownership of a family of "BELL" marks because, it asserts, the key family component linking the marks, "BELL," cannot be at the core of the family because by virtue of the Court order, it cannot be used alone.

This argument makes no sense. In fact it is contrary to the materials submitted by opposer in support of its motion, especially the aforementioned Exhibit 5 and various examples of modifiers, many of which include the term "BELL." Indeed, the "OHIO BELL," "WISCONSIN BELL," "ILLINOIS BELL," "INDIANA BELL" AND "MICHIGAN BELL" marks pleaded by opposer in its notice of opposition are all listed in the Supplemental Agreement as

Opposition No. 86,541

approved modifiers. Simply put, "BELL" is used both alone and with various other terms and designs, and such use appears to be in complete compliance with the supplemental agreement approved by the Court, which expressly sanctions use of "BELL" alone, as long as it is used in sufficient proximity with one of the approved modifiers that consumers will realize that both the mark and the modifier are being used by registrant.

There is no dispute concerning any facts material to the unclean hands defense asserted by applicant, and the undisputed facts material to the issue of opposer's use of its registered concurrent use marks do not provide any basis for applicant's assertion of this equitable defense.

Moreover, applicant's claim which it asserts as the affirmative defense of unclean hands actually constitutes an impermissible collateral attack on the validity of opposer's pleaded concurrent use registrations. The claim that use of the registered "BELL" marks alone is unlawful appears to be one which should have been asserted as the basis for a counterclaim to cancel opposer's registrations, rather than as an equitable defense. The Board cannot entertain an attack on the validity of these registrations in the absence of a counterclaim for

Opposition No. 86,341

cancellation. *Haveg Industries, Inc. v. Shell Oil Co.*, 199 USPQ 618 (TTAB 1978), (aff'd CCPA, 1979). Contrary to the assertion of applicant, the mere filing of the opposition, without additional conduct which demonstrates bad faith or behavior contrary to law, does not make opposer the possessor of unclean hands. See: *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992), and *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265 (TTAB 1977).

In addition to this attack on the registered concurrent use marks asserted in applicant's affirmative defense, applicant argues that opposer has no basis to assert that it owns a family of marks because the marks asserted to be members of the family have not been promoted together. Based on the materials submitted in connection with the motion, this argument is well taken.

It is well settled that "the mere ownership of a number of marks sharing a common feature (or even ownership of registrations thereof) is insufficient to establish a claim of ownership of a 'family' of marks characterized by the feature in the absence of competent evidence showing that... the various marks said to constitute the 'family', or at least a goodly number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the 'family' characteristic..." *Hester Industries, Inc. v. Tupon Foods Inc.*, 2 USPQ2d 1646 (TTAB 1986). In the case before us, we have sparse evidence of promotion and use of the various "BELL" and bell design marks together as a family. We therefore cannot

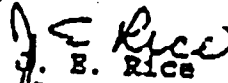
extend to opposer the broader scope of protection which would be accorded to a family of marks. Such an extension is not needed in this case, however, because each of the pleaded registered marks constitutes a proper basis for opposition without resort to the claim of membership in a family of marks.

As we discussed in detail above, the dominant term in applicant's mark is very similar to opposer's marks, "BELL," the bell design, and the marks which combine "BELL" with other words and bell designs. When the marks of the parties are considered in their entireties, the mark of applicant so resembles opposer's marks as to be likely to cause confusion, especially in view of the fame of opposer's "BELL" mark, the fact that opposer sells the products on which applicant intends to use its proposed mark, and the fact that opposer uses its "BELL" marks on goods and services which are closely related to applicant's planned product. Applicant has not demonstrated the existence of factual disputes concerning the strength of opposer's marks or the relationship between opposer's products and services and applicant's planned product, nor has applicant otherwise met its burden under Rule 56(e) of providing evidence in support of its argument that based on the undisputed facts, opposer is not entitled to judgment as a matter of law.

Opposition No. 86,41

The undisputed facts lead us to conclude that confusion is likely as a matter of law, and that the affirmative defense asserted by applicant is meritless. Accordingly, opposer is granted summary judgment. The opposition is sustained and registration of applicant's mark is denied under Section 2(d) of the Lanham Act.


J. D. Sams


J. E. Rice



R. F. Cissel
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

EXHIBIT 9

943

FILED IN CLERK'S OFFICE
U.S.D.C. - AtlantaIN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA SEP 23 1994
ATLANTA DIVISION

BELLSOUTH CORPORATION

Plaintiff,

v.

B.E.L.-TRONICS LIMITED (Canada):
and B.E.L.-TRONICS LIMITED
(Kansas),

Defendants.

CIVIL ACTION NO.
1-93-CV-1714-CCLUTHERD THOMAS, Clerk
By: *Patricia L. Daniels*
Deputy ClerkORDER

The above-styled case is before this court on Plaintiff BellSouth Corporation's (hereinafter "BellSouth") motion for permanent injunction and damages. BellSouth brought its complaint alleging five (5) counts: (1) for infringement of BellSouth's federally-registered Bell trademarks, including U.S. Reg. No. 1,565,562 for the mark BELL, under 15 U.S.C. § 1114; (2) for unfair competition under 15 U.S.C. § 1125(a); (3) for deceptive trade practices and unfair competition under O.C.G.A. §10-1-370; (4) for dilution of a distinctive trademark under §10-1-451; and (5) for unfair competition under the common law of Georgia, based on alleged trademark infringement, unfair competition, deceptive trade practices and dilution by the defendants B.E.L.-Tronics Limited (Canada) and B.E.L.-Tronics Limited's (Kansas), (hereinafter collectively "Bel-tronics"). More specifically, BellSouth contends that a significant number of consumers

likely to be confused into believing that BEL-TRONICS telephone products are affiliated, associated or connected with the companies that share in the "Bell System" heritage, including BellSouth. BellSouth further contends that the use of the BEL-TRONICS on telephones and related products dilutes the distinctive quality of BellSouth's BELL marks. Bel-tronics filed a counterclaim for declaratory judgment alleging that BellSouth did not own a family of BELL marks and that BELL marks had been abandoned by BellSouth. Prior to trial, Bel-tronics filed a stipulated voluntary dismissal, with prejudice, of its counterclaim, and amended its Answer and Counterclaim to withdraw its affirmative defenses pertaining to abandonment.

The court, having considered all of the evidence, including the exhibits and testimony of lay and expert witnesses for both the Plaintiff and defendants, makes the following findings of fact and conclusions of law,

I. FINDINGS OF FACT

A. PARTIES, JURISDICTION AND VENUE

1. Plaintiff BellSouth is a Georgia corporation having its principal place of business at 1155 Peachtree Street, Atlanta, Georgia.

2. Defendant Bel-Tronics Limited (Canada) is a Canadian corporation having its principal place of business at 2422 Dunwin Drive, Mississauga, Ontario, Canada.

3. Defendant Bel-Tronics Limited (Kansas) is a Kansas corporation having its principal place of business at 8100 Sagl Parkway, Covington, Georgia.

4. Defendant Bel-tronics is a wholly-owned subsidiary of Defendant Bel-tronics Limited (Canada).

5. Plaintiff BellSouth has its principal place of business in the Northern District of Georgia.

6. Defendant Bel-tronics Limited (Kansas) has its principal place of business in the Northern District of Georgia.

7. Defendant Bel-tronics Limited (Canada) has its principal place of business in Ontario, Canada.

8. The court has jurisdiction over the parties and the subject matter of Counts I and II of BellSouth's complaint (for federal trademark infringement under 15 U.S.C. § 1114 and federal unfair competition under 15 U.S.C. § 1121) pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338.

9. The court has jurisdiction over the parties and the subject matter of Counts III, IV, and V of BellSouth's complaint pursuant to the doctrine of supplemental or pendant jurisdiction. Venue is appropriate in the Northern District of Georgia under 28 U.S.C. §§ 1391 and 1400(b).

B. BELL SYSTEM HERITAGE

10. Prior to divestiture of the American Telephone & Telegraph Company ("AT&T"), the "BELL System" included twenty-

two (22) "BELL" operating telephone companies that provided local telephone exchange services. Each operating company was owned by AT&T and each had the right to use the "BELL" name and marks, including the mark "BELL" and the "Bell Logo", in connection with the various telephone-related goods and services. United States v. Western Electric Co. Inc., 569 F.Supp. 1057, 1062, n.5, 1074, 1077-81 (D.D.C. 1983).

11. Two such "BELL" operating telephone companies were Southern Bell Telephone & Telegraph Company ("Southern Bell") and South Central Bell Telephone Company ("South Central Bell"). Southern Bell first entered the telephone business in the 1800's, and provided telephone exchange services in certain areas of the states of North Carolina, South Carolina, Georgia, Florida, Alabama, Mississippi, Louisiana, Tennessee and Kentucky previously served by Southern Bell.

12. Southern Bell offered telephone exchange services as early as 1879. Southern Bell used the "BELL LOGO" as early as 1888 and repeatedly thereafter. Southern Bell used the mark BELL as early as 1905 and repeatedly thereafter. BellSouth introduced a series of exhibits documenting the longstanding use of these marks and the oral testimony of Charles Rogers, a long-time employee of Southern Bell.

13. As a result of the exclusive and extensive use by the BELL operating companies, including Southern Bell and South Central Bell, the mark BELL and the "BELL LOGO" acquired significant goodwill and became famous trademarks. Southern

Bell and South Central Bell shared in the heritage of the former "Bell System" and the related goodwill, as represented in part by the mark BELL and the "Bell Logo".

14. In United States v. American Tel. and Tel. Co., 552 F.Supp. 131 (D.D.C. 1982), the District Court for the District of Columbia (D.C. Court) divested the "Bell System" telephone companies from AT&T and established seven regional companies as holding companies for the twenty-two former "Bell System" telephone companies. See United States v. Western Electric Co., Inc., 569 F.Supp. 1057, 1062, n.5 (D.D.C. 1983). BellSouth is the regional holding company for Southern Bell and South Central Bell and, therefore, the successor-in-interest to AT&T. The other six regional companies are Ameritech, Southwestern Bell, NYNEX, Bell Atlantic, US West and Pacific Telesis. These seven regional companies are referred to as the "Regional Bell Operating Companies" or the "Baby Bells."

15. The D.C. Court ordered AT&T to submit a plan of reorganization. The D.C. Court ordered that the plan of reorganization provide for use of the "Bell" name and marks, including the BELL and the "Bell Logo", by the operating companies. The D.C. Court further ordered that ownership of the "Bell" name and marks should be passed directly to the regional companies. United States v. Western Electric Co., Inc., 569 F.Supp. at 1079 (D.D.C. 1983).

16. First, the D.C. Court emphasized and relied on the

fact that the BELL marks had acquired valuable and extensive goodwill with the public. The D.C. Court referred to it as a "historical fact" that the Bell System had become "fixed in the national consciousness..." United States v. Western Electric Co., Inc., 569 F.Supp at 1076 (D.D.C. 1983).

17. Second, the D.C. Court held that the BELL marks should be used by the regional companies so that they could use their "existing relationship to telephone subscribers" to market customer premise equipment.

18. Third, the D.C. Court recognized that the use of the BELL marks by several of the Bell telephone companies would confuse the public between the various companies and placed certain restrictions on the use of the BELL marks to be assigned from AT&T. Pursuant to the orders of the D.C. Court, AT&T assigned all of its rights, title and interest within the United States to the "BELL" name and marks, together with the goodwill symbolized thereby, to the regional holding companies. BellSouth thus obtained exclusive right in and to the mark BELL and the "Bell Logo", subject only to the concurrent use rights of the other divested companies that share in the former "Bell System" heritage.

19. The regional companies subsequently entered into a Supplemental Agreement whereby each regional company was to use a modifier in conjunction with the assigned "BELL" name and marks, both inside and outside of its territory.

20. Under the terms of the D.C. Court, use of a

modifier in conjunction with the BELL mark is accomplished if the modifier is "used in sufficient proximity to the mark such that a reasonable observer would normally view the mark and the modifier in a single visual impression and would recognize that the Assigned mark is being used by the same entity as is using the modifier.

C. ADOPTION, USE AND REGISTRATION OF BELL SOUTH'S BELL MARKS

21. The United States Patent and Trademark Office subsequently issued such concurrent trademark and service mark registrations to the regional companies.

22. One assigned mark was the word BELL. BellSouth was issued U.S. Trademark/Service Mark Registration No. 1,565,562 for the mark BELL for various telecommunications-related goods and services, specifically including "telephones" and "telephone accessories." This registration was issued on November 14, 1989, and is valid, subsisting and unrevoked. This registration is prima facie evidence of BellSouth's exclusive right to use the mark BELL in commerce in connection with the goods and services specified in the registration, subject only to the concurrent use rights of the other regional companies that share in the "Bell System" heritage.

23. Similarly, the other regional companies were issued registrations for the mark BELL for various telecommunications goods and services, specifically including "telephones" and "telephone accessories."

24. Another assigned mark was the "Bell Logo." BellSouth was also issued U.S. Trademark/Service Mark Registration No. 1,569,327 for the "Bell Logo" for various telecommunications-related goods and services, including telephones and telephone accessories. The registration issued on December 5, 1989, and is valid, subsisting and unrevoked. This registration is prima facie evidence of BellSouth's exclusive right to use the "Bell Logo" in commerce in connection with the goods and services specified in the registration, subject only to the concurrent use rights of the other companies that share in the "Bell System" heritage.

25. BellSouth's subsidiary continued to use the mark Southern Bell. BellSouth obtained U.S. Trademark/Service Mark Registration No. 1,459,998 for the mark SOUTHERN BELL for various telephone-related goods and services. The registration issued on October 6, 1987, and is valid, subsisting and unrevoked. This registration is prima facie evidence of BellSouth's exclusive right to use the mark SOUTHERN BELL in commerce in connection with the goods and services specified in the registration.

26. BellSouth's subsidiary South Central Bell continued to use the mark SOUTH CENTRAL BELL. BellSouth obtained U.S. Trademark/Service Mark Registration No. 1,459,194 for the mark SOUTH CENTRAL BELL for various goods and services. This registration issued on September 29, 1987, and is valid, subsisting and unrevoked. This registration is

prima facie evidence of BellSouth's exclusive right to use the mark SOUTH CENTRAL BELL in commerce in connection with the goods and services specified in the registration.

27. BellSouth also adopted and used certain new BELL marks on the foundation of its exclusive right to use the BELL name. BellSouth obtained U.S. Trademark Registration No. 1,565,559 for the mark BELLSOUTH for various goods, including telephones and telephone accessories. This registration issued November 14, 1989 is valid, subsisting, and unrevoked. This registration is prima facie evidence of BELLSOUTH's exclusive right to use the mark BELLSOUTH in commerce in connection with the goods specified in the registration.

28. BellSouth has obtained U.S. Trademark Registration No. 1,698,835 for the mark BELLSOUTH PRODUCTS of various telephone-related goods, including telephones, cordless telephones, telephone accessories and telephone answering machines. This registration issued on July 7, 1992, is valid, subsisting and unrevoked. This registration is prima facie evidence of BellSouth's exclusive right to use the mark BELLSOUTH PRODUCTS in commerce in connection with the goods specified in the registration.

29. BellSouth has introduced substantial evidence that it has used and continues to use each of these marks. BellSouth has used the mark BELLSOUTH to promote the telephone goods and services of its affiliates. The marks BELL, SOUTHERN BELL, and the BELL Logo have been used since

approximately the turn of the century in association with telephone services and related goods. South Central Bell has used the marks SOUTH CENTRAL BELL and the BELL Logo since 1968. BellSouth Telecommunications, Inc., doing business as "Southern Bell" and "South Central Bell" has continued to use the BELL marks, in association with caller identification services. BellSouth Advertising & Publishing Corporation has used the mark BELL SOUTH, the BELL Logo, SOUTHERN BELL and SOUTH CENTRAL BELL in association with telephone directories and related services. BellSouth Products, Inc. has used the mark BELL SOUTH PRODUCTS on and in association with cordless telephones, telephone answering machines and caller identification units.

30. BellSouth offers and sells telephones and telephone-related products, including cordless telephones, answering machines and caller identification units on a nationwide basis, including Georgia, through its exclusive distributor, U.S. Electronics, Inc. BellSouth does not sell directly to consumers.

31. BellSouth Products, Inc., through U.S. Electronics, Inc., sells telephones and telephone-related products, including cordless telephones, answering machines and caller identification units in catalogs, retail stores and mass merchandising establishments. Such establishments include Macy's, Rich's, Target, Wal-Mart, Sam's, Montgomery Ward, Ace Hardware, Service Merchandise, Sam's Warehouse Club,

Office Depot, Office Warehouse, Lechmere, Best Buy, Harco Drugs and Lurias. BellSouth also sells its telephones and related goods in catalogs, such as airline flight guides.

32. BellSouth advertised telephones and telephone-related products, including cordless telephones, telephone answering machines and caller identification units in print media, including trade publications, brochures, flyers, etc., at trade shows and by direct contact. BellSouth sells a wide range of cordless telephones, ranging in price from a low of about \$39.00 to \$49.00 to a high of about \$150.00 for a telephone integrated with another device such as an answering machine. BellSouth and its exclusive distributor have spent substantial sums advertising the BELL mark.

33. U.S. Electronics, Inc. also promotes telephones and telephone-related products bearing the marks BELLSOUTH PRODUCTS and the "Bell Logo." U.S. Electronics provides "co-op" advertising for retailers that results in advertising in brochures such as Sunday newspaper inserts, flyers, etc., and in electronic media such as television, radio and advertisements.

34. Mr. Andrew Lowinger, President of U.S. Electronics, Inc., testified that the BELL name was very valuable in the sale of telephones, cordless telephones, telephone answering machines and caller identification equipment. Mr. Lowinger also testified that the marketplace for such products is segmented, in that many retailers and

mass merchandisers will offer a BELL brand and certain other brands.

35. Within the state of Georgia and in interstate commerce, BellSouth and its subsidiaries have engaged and continue to engage in extensive advertising and promotion of their trademarks, service marks and trade names.

D. PUBLIC RECOGNITION

36. Within the state of Georgia and in interstate commerce, BellSouth and its subsidiaries have used and continue to use the "Bell" name and marks.

37. BellSouth has adopted, used and uses a well-known group of marks that incorporates various other terms and designs in conjunction with the root word "BELL." BellSouth has used and promoted its Bell marks together, so as to create among purchasers an association of common ownership with the family of Bells.

38. Charles Rogers, President of BellSouth testified that he has no recollection of BellSouth ever using the BELL word mark alone or without the approved geographic modifiers. Since divestiture, BellSouth has never used the BELL or BELL Logo marks, standing alone, to identify its telephone products and services.

E. B.E.L.-TRONICS AND ITS MARK "BEL-TRONICS"

39. Bel-tronics was originally founded in 1967 as Blitz Electronics Limited. In 1970, the company's name was abbreviated to B.E.L.-Tronics Limited.

40. Neither of the defendants have any affiliation, association or connection with or authorization from BellSouth or any of its affiliated companies.

41. Bel-tronics began its business manufacturing automotive-related products and is recognized as a leading manufacturer of radar and laser detection equipment. Bel-tronics' radar detectors are identified worldwide under the trademarks BEL-TRONICS, BEL-TRONICS LIMITED, BEL and by the BEL logo, which consists of the letters "BEL" in an ellipse (hereinafter the "BEL Logo"). Its current line of consumer electronics products also includes a golf head speed measuring device and the products in issue in this case, cordless telephones and caller identification units. In the mid-1980's, Bel-tronics offered and sold satellite television equipment for approximately eighteen (18) months. The slogan "Clear as a BEL" is used in conjunction with the sale of this equipment and not telephones.

42. B.E.L-Tronics is the owner of a U.S. Trademark Registration, U.S. Registration No. 1,765,584 for the BEL Logo.

43. The BEL Logo is also registered in numerous foreign countries including Germany, England, and Japan. The U.S. Registration is for goods described as radar detectors, intruder alarms and burglar alarms in International Class 9, the same class covering most consumer electronics goods, including telephones.

44. Bel-tronics first began to consider entering the telephone or telecommunications market in 1989. Bel-tronics was aware of a potential problem using its corporate identity on telephones and related products, but desired to transfer the goodwill that it had built in the automotive-related products industry to the telecommunications industry. A trademark search done in October, 1989, for the mark BEL for cordless telephones located BellSouth's pending concurrent use application for federal registration of the mark BELL and the registration applications filed by the other six regional companies for the BELL mark. On October 16, 1991, Mr. Makk, an engineer with Bel-tronics, raised concerns over possible trademark infringement problem in using the "BEL" mark on telephones to Mr. Fuhrmann, Vice President of the marketing sales at the time.

45. On March 11, 1991, about three and a half years ago, Bel-tronics filed an intent-to-use application to register a new mark for cordless telephones, the "BEL BELTRONICS and ELLIPSE DESIGN mark." The application was filed under the intent to use provisions of 15 U.S.C. § 1051(b). The proposed BEL BELTRONICS and Design mark was published for purposes of opposition in accordance with 15 U.S.C. §1062.

46. Five of the seven regional Bell companies filed opposition to the registration of the BEL BELTRONICS and Design mark on the grounds that the mark was confusingly

similar to each of the regional Bell companies' set of BELL marks used to identify various telecommunications services and products.

47. Bel-tronics filed a motion to consolidate all claims opposing its BEL BELTRONICS mark. This motion was denied on October 22, 1992, on the grounds that the regional Bell companies did not share a common interest and that each of the companies claimed ownership to different trademark registrations, and, thus, their cases would be based on a set of facts unique to each opposer. The United States Patent and Trademark Office's Trademark Trial and Appeal Board (hereinafter "T.T.B.") held in NYNEX and Ameritech decision, two of the seven regional Bell companies opposing the BEL BELTRONICS mark, that there was a likelihood of confusion between the BEL BEL-TRONICS & Design and the "BELL" marks owned by Ameritech and NYNEX. See Ameritech, at 13; NYNEX at 11. In addition, the T.T.A.B. held that the plaintiff and the other regional bell companies have used their concurrent registrations of the "BELL" and the "BELL Logo" marks in compliance with the court's order in United States v. Western Electric Co., 569 F.Supp. 1057 (D.D.C.), aff'd sub nom., California v. United States, 464 U.S. 1013 (1983). See Ameritech, at 12; NYNEX, at 9. Southwestern Bell, at 7; BellSouth, at 7-8.

48. In view of the pending opposition, Bel-tronics decided not to use either the BEL in the ellipse mark or its

applied for BEL BELTRONICS and Design mark on telephone products. Thus far, Bel-tronics has only affixed the mark BEL-TRONICS and the trade name BEL-TRONICS LIMITED to any telephone or related product. Bel-tronics has not used the BEL & Design or BEL BEL-TRONICS & Design marks to identify their telephones or related products.

49. Bel-tronics announced in January, 1993, that it would begin selling telecommunications products. At the bi-annual Consumer Electronics Show, Bel-tronics displayed cordless telephones and caller-id units bearing the mark BEL-TRONICS. These phones were prototypes and not available for sale at that time. Mr. Rogers, President of BellSouth's Products, Inc. testified that he believed Bel-tronics was merely testing the marketplace.

50. Bel-tronics displayed actual cordless telephones and caller identification units bearing the mark BEL-TRONICS at the June, 1993, Consumer Electronics Show.

51. Bel-tronics subsequently began to sell its first caller identification units and 900 MHz cordless telephones. Bel-tronics 46/49 MHz cordless telephones were never sold or offered to the public. Bel-tronics intends to make and sell telephone answering machines in the near future.

52. Bel-tronics' "Caller ID" units offered for sale constitute an accessory product. The caller-id units are functional only if the local telephone company offers caller identification services.

53. Bel-tronics has offered and sold 900 MHz cordless telephones to the public. This telephone uses a different frequency from the 46/49 MHz telephones offered by BellSouth and is sold at retail for approximately \$279.00. BellSouth does not offer a 900 MHz telephone product at this time. There was testimony that other manufacturers offer the 900 MHz telephones for a somewhat lesser cost, but not around the price range of the BellSouth telephones.

54. Since August, 1993, Bel-tronics has sold cordless telephones and caller identification units in various channels of trade. Bel-Tronics cordless telephones and caller-id units have been sold through catalogs, such as Delta flight guide and Herrington's catalogs, and at mass merchandising outlets and retail stores such as Macy's and Wal Mart. Bel-tronics' telephone-related products are advertised in flyers, trade journals, magazines and on radio.

55. BellSouth and Bel-tronics both advertise in Herrington's and certain flight guides. In the Herrington catalog was an expression "With BEL in your shirt pocket..." with reference to the BEL-TRONICS' cordless telephone. Bel-tronics has instructed its sales representatives to object to such uses of the BEL with telephones and related products. Several of the advertisements however, were run after Bel-tronics had given such instruction. Bel-tronics and the public have used BEL as a shorthand reference of B.E.L.-Tronics.

56. The dominant portion of the defendants' mark is the word "BEL", which is combined with the term "tronics", as BEL-TRONICS. See Ameritech, p.6 (PTX 166); NYNEX, p.7 (PTX 167).

F. CONFUSION RESULTING FROM USE OF THE MARK "BEL-TRONICS"

57. BellSouth has introduced different forms of actual confusion evidence resulting from the use of the mark BEL-TRONICS on cordless telephones and caller identification equipment. BellSouth introduced evidence of telephone business professionals that testified that they were confused, namely Mr. Malcolm Paton and Earl Signer. Mr. Paton, President of HB Electronics testified that he saw the Bel-tronics telephone display at the June 1993 Consumer Electronics Show and mistakenly believed that Bel-tronics was associated with a former Bell System Company. Mr. Signer, former national buyer for Sears Roebuck for all telephones and telephone-related products, testified that he believed that most retail consumers, upon seeing a BEL-TRONICS cordless telephone would assume some association with one of the BELL companies.

58. BellSouth has shown that approximately twenty (20) consumers who purchased a BELLSOUTH PRODUCTS telephone product have mistakenly contacted Bel-tronics for warranty service and/or repair. There was evidence that some of these calls may have been misdirected by the retailers.

59. BellSouth conducted a survey indicating that a

substantial number of respondents were confused as to the source of the BEL-TRONICS product.

60. Mr. Harry O'Neil, Vice Chairman of Roper Starch Worldwide, Inc., a market research firm, testified concerning a study conducted by his organization. The study was done among 323 respondents that either had cordless telephones in their homes or were in the market for a cordless telephone over the next 12 months. The respondents were interviewed in eight malls in eight cities. The eight cordless telephones were shown in random order.

61. In answer to the first question, seventy-one (71) respondents (22%) wrongly believed that Bel-tronics was associated with a telephone company. Of those 71 respondents, 75% believed the Bel-tronics telephone was associated with a telephone company because of the name BEL-TRONICS.

62. Mr. O'Neil testified that this data establishes that there is a significant level of confusion as to the source of the Bel-tronics cordless telephone. Fifteen percent (15%) represents the threshold to establish a likelihood of confusion.

63. On cross-examination, Mr. O'Neil testified that 2% of persons surveyed thought there was a connection between Bel-tronics telephone and BellSouth telephones.

64. Bel-tronics' gross sales of telecommunications products through June 30, 1994, was approximately \$3,915,711 (\$2,894,161 in telephones and \$1,021,550 in caller-ID units).

Bel-tronics presented evidence that it had suffered a net loss of \$446,482 before taxes with respect to caller identification units.

65. Defendants presented testimony that it had a "Gross Margin" on telecommunication products of \$993,454, a net loss of \$446,482 on cordless telephones and a net income before taxes of \$10,483 on caller identification units. This evidence was uncontroverted.

II. CONCLUSION OF LAW

A. JURISDICTION, VENUE AND GENERAL LAW

1. The purpose of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) was set out in Gold Seal Co. v. Weeks, 129 F.Supp. 928 (D.D.C. 1955), aff'd sub nom, S.E. Johnson & Sons, Inc. v. Gold Seal Co., 230 F.2d 832 (1956) as:

It [43(a)] represents, within this area, an affirmative code of business ethics... In effect, it says: you may not conduct your business in a way that unnecessarily and unfairly interferes with and injures that of another; you may not destroy the basis of genuine competition by destroying the buyer's opportunity to judge fairly between rival commodities.

Id. at 940.

2. In order to succeed in the present cause of action under Section 43 of the Lanham Act, 15 U.S.C. § 1125(a), plaintiff BellSouth must prove that B.E.L.-tronics:

- (1) uses a word, term, name, symbol, or device, or any combination thereof; or false designation of origin;
- (2) in interstate commerce;
- (3) in connection with goods and services;

(4) that is likely to cause confusion as to the affiliation, connection or association of defendant with another person or the origin, sponsorship or approval of defendant's goods or commercial activities by another person; and;

(5) BellSouth has been or is likely to be damaged by these acts. See also 15 U.S.C. §1125(a)(1).

3. The Eleventh Circuit has identified certain factors to be considered in determining whether a likelihood of confusion exists: (1) the type of trademark at issue; (2) similarity of design; (3) similarity of product; (4) identity of retail outlets and purchasers; (5) identity of advertising media; (6) defendant's intent; and (7) actual confusion. Safeway Stores, Inc. v. Safeway Discount Drugs, Inc., 675 F.2d 1160, 1163 (11th Cir. 1982); E. Remy Martin & Co., S.A. v. Shaw-Ross Int'l Imports, Inc., 756 F.2d 1525, 1530-33 (11th Cir. 1985).

4. The court may consider other probative evidence that does not fit within any of the factors. Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956, 958 (11th Cir. 1986).

5. Likelihood of confusion is a question of fact that must be proven by preponderance of the evidence. John H. Harland Co. v. Clark Checks, Inc., 711 F.2d 966, 972-3 (11th Cir. 1983).

6. In examining the factors necessary for proving likelihood of confusion, "a plaintiff need not show all, or

even most, of the factors... in any particular case to be successful." Wynn Oil Co. v. Thomas, 839 F.3d 1183, 1186 (6th Cir. 1988); Gold Kist, Inc. v. Conagra, Inc., 708 F.Supp. 1291, 1296 (N.D. Ga. 1989); Citibank N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 1547-8 (11th Cir. 1984).

7. The proceedings of the TTAB are relevant evidence for the court to consider. Eleventh Circuit precedent establishes that the findings of the TTAB will control in a subsequent infringement suit between the same parties unless the contrary is established by evidence that, in character and amount, carries thorough conviction. American Heritage Life Insurance Co. v. Heritage Life Insurance Co. 494 F.2d 1176, 1180-1 (11th Cir. 1985).

B.. BELLSOUTH'S TRADEMARK RIGHTS

8. BellSouth is the lawful owner of the mark BELL for a wide variety of telephone-related goods and services. BellSouth has used this mark in accordance with the orders and opinions of the D.C. Court, which requires that the Bell marks be used in conjunction with a geographic identifier. The mark has been and continues to be a famous trademark. By virtue of BellSouth and its subsidiaries' longstanding and extensive use, promotion and advertising, an in view of the public's recognition of the mark, BELL, used in connection with a geographic identifier has come and continue to indicate BellSouth's and its affiliates as being connect to the Bell System as a source for telephone-related goods and services.

9. BellSouth is the owner of the following registrations for BELL trademarks:

Reg. No.	Mark	Goods
1,565,562	BELL ¹	Telephone and telephone accessories
1,569,327	BELL Logo ²	Telephone and telephone accessories
1,327,695	BELL Logo ³	Telecommunication services
1,565,559	BELLSOUTH	Telephone and telephone accessories
1,459,196	BELLSOUTH	Providing telecommunications services to others
1,459,998	SOUTHERN BELL	Providing telecommunications services to others
1,459,194	SOUTH CENTRAL	Providing telecommunications services to others
1,698,835	BELLSOUTH PRODUCTS	Customer premises telecommunications networks and parts therefor; telephones, cordless telephone accessories; modems; computers; printers; facsimile machines; multiplexors; computer terminals; telephone answering machines; voice mail systems comprising telephone and computer interface; computer programs and controls for delivering and receiving messages over telephone lines; and computer programs dealing with telecommunications and business management.

¹In conjunction with geographic modifier

²In conjunction with geographic modifiers

³In conjunction with geographic modifier

10. BellSouth's trademark registrations constitute prima facie evidence of validity thereof, and of BellSouth's ownership of the respective marks identified therein and of BellSouth's exclusive right to use said marks in connection with the goods and services specified therein. 15 U.S.C. § 1057(b); Rotor Rooter Corp. v. O'Neil, 513 F.2d 44 (5th Cir. 1975).

11. BellSouth is the owner of exclusive rights in and to the BELL marks owned and used by BellSouth and its subsidiaries. Such exclusive rights are embodied in BellSouth's federally-registered BELL marks set forth above.

12. BellSouth established ownership of a family of BELL marks by using and promoting the BELL mark together in such a manner as to create among purchasers an association of common ownership with the historical BELL system and is entitled to broader protection. Hester Industries Inc. v. Tupon Foods, Inc., 2 U.S.P.Q.2d 1646 (TTAB 1986); J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460 (Fed. Cir. 1991).

C. LIKELIHOOD OF CONFUSION

13. The strength of a trademark is essentially a consideration of "distinctiveness." A strong mark is very distinctive and widely protected; a weak mark is not. University of Georgia Athletic Assn. v. Laite, 756 F.2d 1535 (11th Cir. 1985).

14. The factors to be considered in determining

whether a trademark is strong or weak include (a) the type of mark, i.e., whether the mark is, in ascending order of strength, descriptive, suggestive, arbitrary or coined, Safeway Stores, Inc., 675 F.2d at 1164); (b) the amount of use of the term by others in the same product and geographical area; and (c) consumer recognition of the mark based on its use, the amount of advertising and promotion done under the mark, John H. Harland Co. v. Clark Checks, Inc., 711 F.2d at 956, 973-5 (11th Cir. 1986).

15. An arbitrary mark is a "word in common use, but not applied to a product or service unrelated to its meaning, so that the word neither describes nor suggests the product or service..." Jellibeans, Inc. v. Skating Clubs of Georgia, Inc., 716 F.2d 833, 846 (11th Cir. 1983). As the word BELL has no relationship to telephone-related goods and services, the BELL marks are, therefore, arbitrary trademarks.

16. The strength of the BELL marks is further found in their ability to distinguish goods and services on two levels. First, each BELL mark indicated that the goods and services offered thereunder are provided by a company that shares in the heritage of the former "Bell System". Second, when used in conjunction with a geographic modifier, a BELL mark, such as BellSouth indicates from which BELL company such goods or services originates.

17. The strength of the BELL marks is further found in their longstanding use. BellSouth and its subsidiaries

have made extensive use of the BELL marks for a significant period of time. The BELL name was first used by the former Southern Bell in 1879.

18. Since divestiture, BellSouth has developed a family of company names and marks by which it uses the common element of the BELL together with its geographic modifier.

19. The public long ago came to associate the mark BELL with the high quality telecommunications goods and services originating with the BELL System.

20. Bel-tronics has introduced evidence that there are several companies whose names begin with the letters "BEL" or "BELL" listed in an electronics telephone directory.

21. There is no evidence that any of these companies, other than the divested former BELL System companies, manufacture telephones or related products or provide telephone services.

22. In view of the fact that the BELL marks are each arbitrary trademarks, that BellSouth and its subsidiaries have made extensive and exclusive use of the BELL marks in association with telephones and related goods and services, and have spent substantial sums in advertising its telephone-related services under these marks, the court finds that the BELL mark is a strong and famous trademark for telephones and related goods and services. In view thereof, BellSouth has a broad scope of protection for its BELL marks. Hester Industries Inc. v. Tupon Foods, Inc., 2 U.S.P.Q.2d 1646 (TTAB

1986); J&J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460 (Fed. Cir. 1991).

D. SIMILARITY BETWEEN THE BELL MARKS AND B.E.L.-TRONICS MARKS

23. In evaluating similarity of the marks, the court must examine the overall impression created by the marks, including the manner in which they are displayed. E. Remy Martin & Co., 756 F.2d at 1531.

24. Similarity of marks "is determined by considering the overall impression created by the mark[s] as a whole. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d at 975 (11th Cir. 1983). However, "it is [also] appropriate in determining the question of likelihood of confusion to give greater weight to the ... dominant parts of a composite mark, for it is that which may make the greatest impression on the ordinary buyer." James Burroughs Ltd. v. Sign of the Beefeater, Inc., 572 F.2d 574, 577 (7th Cir. 1978). The dominant portion of the BEL-Tronics mark is the word "BEL".

25. At the outset, Bel-tronics contended that the comparison made is merely between BELLSOUTH PRODUCTS and BEL-TRONICS because the marks appear on the telephones offered by the respective parties. However, for purposes of the plaintiff's trademark infringement case, the court must also consider the similarities between the mark BELL as shown in U.S. Trademark Registration No. 1,565,562 (PTX 36), subject to the conditions of use set forth therein, and the BEL-TRONICS mark shown on cordless telephones, caller identification

units, or telephone answering machines. The BELL mark is registered for telephones and accessories and telephone answering machines. These are the very goods at issue in this case. The BELL mark creates the impression of a bell, as in the sounding of a bell. The BEL prefix in BEL-TRONICS creates an identical sound as the BELL prefix in BELLSouth. The mark BELL is identical to the BEL prefix in sound and only slightly differs in spelling. There has been testimony in this case that the BEL-TRONICS may be confused for a contraction of BELL ELECTRONICS. When BEL-TRONICS is placed on a telephone or related product, the public is likely to believe that it is associated or connected with BellSouth or some other BELL company. This association is directly resulting from the similarity of the BEL-TRONICS and the federally registered BELL marks.

26. In view of the similarity, relatedness and identity of the goods and services of the parties hereto, confusion is likely between the Bel-tronics and BellSouth marks for telephone and telephone-related products.

27. Both the BellSouth and Bel-tronics offer and sell telephones and caller identification units. Although the Bel-tronics' cordless telephone operates at a different frequency than the BellSouth cordless telephones and the price variations are considerable, the court still finds a likelihood of confusion as to their sources.

28. BellSouth and Bel-tronics employ the same channels of trade in selling and advertising their products.

E. PRIOR KNOWLEDGE BY BEL-TRONICS

29. BellSouth need not show an intent to confuse in order to prove its case for unfair competition and trademark infringement. Jellibeans, Inc., 716 F.2d at 833, n. 23; accord, Travelodge Corp. v. Siragusa, 228 F.Supp. 238, aff'd, 352 F.2d 516 (5th Cir. 1966).

30. Although, one does not have to prove bad faith in order to prevail in an action for trademark infringement of a federally registered mark, a plaintiff must prove more than the defendant's mere knowledge of plaintiff's prior similar mark in order to establish bad faith. Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1565 (Fed. Cir. 1987). In the instant case, Plaintiff has shown that the defendant had prior knowledge of plaintiff's federally registered trademark when it began using the BEL-TRONICS mark on telephones and related products. The court finds this insufficient to establish bad faith. The facts of this case are different from a "newcomer" case where a newcomer enters a market using a well-established mark of another already in that market. Here, Bel-tronics did not select a new mark. Bel-tronics has been selling electronic products using the BEL-TRONICS marks for over twenty-five (25) years, and as part of a natural expansion of its product line, sought to transfer the goodwill that it had built up in the electronic automotive

industry to the telecommunications industry.

31. In determining whether a defendant acted in bad faith in adopting a mark that is so similar to the plaintiff's that it is likely to cause confusion, the court must determine whether the defendant intended to benefit from the plaintiff's reputation. The court finds that Bel-tronics did not intend profit from BellSouth's reputation in the telecommunications industry, but only sought to benefit from its own reputation over the past twenty-five (25) years.

32. Based on the foregoing, the court finds that the record does not support a finding that Bel-tronics acted in bad faith in deciding to use the BEL-TRONICS mark on telephones or related products.

F. ACTUAL CONFUSION

33. BellSouth need not show actual confusion in order to prove its case for unfair competition. E. Remy Martin & Co., 756 F.2d at 1529-30. Even though not required, the court finds that the evidence supports a finding of actual confusion in this case.

34. The evidence of actual confusion includes: (1) confused professionals, such as Malcolm Paton and Earl Signer, Jr.; (2) confused customers or retailers of BellSouth Products' telephone products in misdirecting calls; (3) the mis-advertisements by Hi-Fi Buys and others, including the reference to "Put a BEL in your pocket" (4) confused respondents to a survey conducted by Roper Starch indicating

that 22% of the respondents wrongly believed that Bel-tronics' cordless telephones were associated, affiliated or connected with a telephone company and 75% of those who thought so because of its name. Although Bel-tronics introduced the oral testimony of Mr. Alvin Ossip, who testified that the BellSouth survey had "major flaws" which biased the results against Bel-tronics, in light of the other noted actual confusion, the court finds that the evidence, including the BellSouth survey established actual confusion.

G. DILUTION

35. The Georgia Anti-dilution Statute prohibits use of another mark that will lessen the uniqueness of the prior user's mark. O.C.G.A. §10-1-451(b); Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 265 (5th Cir. 1980), cert. denied, 449 U.S. 899 (1980). A dilution plaintiff need not show that the parties are competitors, nor must the plaintiff show any evidence of actual confusion. Robarb, Inc. v. Pool Supply Builders, 21 U.S.P.Q.2d 1743, 1754 (N.D. Ga. 1991).

36. Dilution requires some proof that use that the use of a trademark (by another) decreases the plaintiff's commercial value. If the plaintiff holds a distinctive trademark, it is enough that the defendant has made significant use of a very similar mark. Community Federal Savings & Loan Assn., 678 F.2d at 1035 (11th Cir. 1982).

37. The court, having found actual confusion, finds that Bel-tronics' use of the mark BEL-TRONICS in connection

40. In order to prevail under the Uniform Deceptive Trade Practices Act, BellSouth need not prove competition between the parties or actual confusion or misunderstanding. O.C.G.A. § 10-1-373(b). The Act further provides that injunctive relief is available without proof of monetary damage, loss of profits or intent to deceive. O.C.G.A. § 10-1-372(a). The requirements for injunctive relief under the Uniform Deceptive Trade Practices Act are less stringent than under any of the other sections dealing with protection of trade name and trademarks. The plaintiff need prove neither actual confusion or direct competition in order to be granted an injunction, but only must show that the defendant's use of a name causes confusion to others using reasonable care. Id.

41. Having already found actual confusion in this case, the court finds that Bel-tronics' use of the mark BEL-TRONICS in connection with telephones and related products is a violation of the Georgia Deceptive Trade Practices Act, O.C.G.A. § 10-1-370 et seq.. A likelihood of confusion has also been shown, as set forth hereinabove.

H. REMEDY

42. Weighing all of the forgoing, the court finds that a telephone or related product bearing the mark BEL-TRONICS is likely to be confused as a product of a company that share in the heritage of the former "Bell System". As such, there exists a likelihood of confusion between BEL-

TRONICS and BellSouth, as one of the former "Bell System" companies. Bel-tronics' adoption and use of the mark BEL-TRONICS in connection with telephones and related products thus constitutes acts of unfair competition and trademark infringement in violation of 15 U.S.C. §1125(a).

43. The court finds that in light of the foregoing, BellSouth has no adequate remedy at law and is, therefore, entitled to injunctive relief precluding further use of the mark "BEL-TRONICS", or any other marks or names confusingly similar to any BELL mark owned by BellSouth.

44. More specifically, for the parties' guidance, the court finds that the defendant is enjoined from use of the marks BEL, BEL in the ellipse, and BEL-TRONICS as a trademark on its telephones, telephone equipment and caller identification units or in connection with any advertisement of the same.

45. As FCC and UL regulations for manufacturers of telephone equipment require that the manufacturer of the equipment be identified on the equipment, CFR § 68.300 and UL 65.2, Defendant is permitted to use its corporate name BEL-TRONICS LIMITED, in connection with telephones, telephone equipment and caller identification units or in connection with any advertisement of the same. To avoid the possibility of confusion with the plaintiff, the defendant must include, adjacent to the corporate name, a disclaimer in the following form: "NOT AFFILIATED WITH ANY FORMER BELL SYSTEM ENTITY"

whenever the corporate identity BEL-TRONICS LIMITED is used in connection with telephones, telephone equipment and caller identification units or in connection with any advertisement of the same

46. The Defendants will be given a period of 90 days to sell off its existing inventory of telephones and caller identification units bearing the BEL-TRONICS mark in forms prohibited by this injunction.

47. A limited injunction is proper in this case for the Bel-tronics has been in business for twenty-five years and should be able to trade off its reputation and good will in the automotive electronics' industry. Additionally, the court finds that the disclaimer will avoid the potential for confusion in the future.

I. DAMAGES

48. When a violation of any right of a trademark owner has been established, the Lanham Act provides for damages for such infringement which may include (1) defendants' profits; (2) any damages sustained by the plaintiff; and (3) the cost of the action. 15 U.S.C. § 1117(a); Ramada Inns, Inc. v. Gadsden Motel Co., 804 F.2d 1562, 1564 (11th Cir. 1986).

49. Although the Eleventh Circuit does not require a higher showing of culpability or bad faith or malice in order for the plaintiff to recover profits, Burger King Corp. v. Mason, 855 F.2d 779, 781 (11th Cir. 1988); Gold Kist, 708

F.Supp. at 1304, the court must look at the totality of the circumstances in order to make determination to award profits. The Eleventh Circuit requires that all monetary awards be made subject to the principles of equity and no hard and fast rules dictate the form or quantum of relief that should be awarded in this case. Burger King Corp. v. Mason, 855 F.2d at 783 (11th Cir. 1988). Section 35 of the Lanham Act, 15 U.S.C. § 1117, "confers upon the district court a wide scope of discretion to determine the proper relief due an injured party." Id. at 781.

50. BellSouth seeks damages based upon the Beltronics' gross sales of infringing merchandise. Having herein found that there exists no evidence of bad faith in the defendants' adopting the trademark BEL-TRONICS, the court finds that the award of the defendant's profits in this case is not justified.

52. BellSouth also requests attorneys' fees in this case. Under 15 U.S.C. §1117, in exceptional cases, this court may award reasonable attorneys' fees to the prevailing party. The standard for the definition of "exceptional" is defined as "malicious, fraudulent, deliberate and willful behavior." Gold Kist, Inc. v. Conagra, Inc., 708 F.Supp. at 1304. The court, having found that although Beltronics was aware of a potential problem using its corporate identity on telephones and related products, it simply desired to transfer the goodwill that it had built in the automotive-related products

industry for over a period of twenty-five (25) years, finds that attorneys' fees are not warranted in this case. The court finds that the defendants' good faith attempt to use its own name and capitalize of the goodwill that it had developed in other markets was reasonable and not for the purpose of leeching off of the heritage of the family of Bells. Accordingly, BellSouth is not entitled to recover enhanced damages or attorney's fees in this case.

53. Any conclusions of law which are properly findings of fact are hereby adopted as such.

CONCLUSION

Plaintiff's request for injunctive relief is hereby GRANTED, subject to the limitations and conditions herein stated. Plaintiff's request for defendants' profits, enhanced damages and attorneys' fees are hereby DENIED.

SO ORDERED this 23rd day of September, 1994.



CLARENCE COOPER
UNITED STATES DISTRICT JUDGE

EXHIBIT 10

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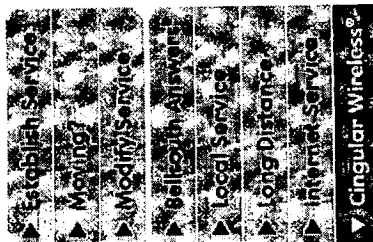
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